

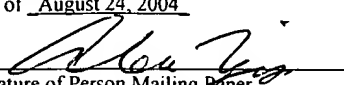
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application : **Group Art Unit: 2642**
N. Elsey et al. :
Serial Number: 09/441,656 : **Examiner: H. Agdeppa**
:
Filed: November 12, 1999 : **Attn. Docket No.: 41698-1012**
:
Title: ENHANCED DIRECTORY ASSISTANCE SERVICE PROVIDING INDIVIDUAL
OR GROUP DIRECTORIES

Commissioner for Patents
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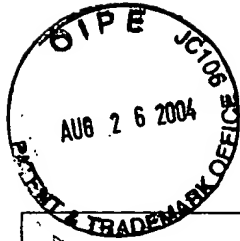
Enclosed are (1) Appellant's Brief on Appeal under 37 C.F.R. 1.192, in triplicate, and (2) a check in the amount of \$330 to cover the required fee pursuant to 37 C.F.R. 1.17(c).

In the event of non-payment of a required fee, the Commissioner is authorized to charge **Deposit Account No. 50-0988** as required to correct the error.

Respectfully submitted,

Date: August 24, 2004

By: 
Alex L. Yip
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PTO Registration 34,759
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APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the Final Rejection, dated March 25, 2004, in which Claims 22-25, 28, 29, 41-44, 46-50, 53, 54, 66-69, and 71-97 of the above-referenced application stand rejected.

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EXHIBIT 2	<i>In re Hall</i> , 228 U.S.P.Q. 453 (Fed Cir. 1986)
EXHIBIT 3	<i>Ex Parte Jones</i> , 62 U.S.P.Q.2d 1206 (Bd. Pat. App. & Inter. 2001)(unpublished)
EXHIBIT 4	<i>In re Dembiczak</i> , 175 F.3d 994 (Fed. Cir. 1999)



I. REAL PARTY IN INTEREST

The real party in interest is METRO ONE TELECOMMUNICATIONS, INC.

II. RELATED APPEALS AND INTERFERENCES

There are no related Appeals and/or Interferences.

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III. STATUS OF CLAIMS

Claims 22-25, 28, 29, 41-44, 46-50, 53, 54, 66-69, and 71-97 are pending in this application. These claims which stand finally rejected are the subject of this appeal. A copy of these claims under appeal are appended hereto (see Appendix A).

IV. STATUS OF AMENDMENTS

A final Office Action rejecting Applicants' claims was mailed on March 25, 2004. No amendment to the final Office Action has been presented.

V. SUMMARY OF THE INVENTION

1. The Problem Solved by the Invention

The invention significantly improves upon traditional methods and systems of data management and access and includes, *inter alia*, novel directory assistance services and systems. For example, in one aspect of the invention, a directory assistance service is provided which manages data sources, such as private directories, on a directory assistance system for users. Users can directly create such private directories and the like on the directory assistance system, such as by using the Internet to access graphical user interfaces (GUIs) provided by the directory

assistance provider. Alternatively, the user can have the directory assistance provider create such private directories for him, such as by calling a human directory assistance operator and asking the operator to create them. A private directory may contain contact information for an individual or a group, and may include information known to the user which is unlisted or not contained in the commercial databases used by directory assistance providers.

Users may choose to create different private directories containing different types of information. For example, an individual may establish a first private directory to contain the individual's personal contact information (e.g., friends' and relatives' contact information), and a second private directory to contain the individual's business contact information (e.g., coworkers' and business associates' contact information). A corporation may also take advantage of the invention by establishing a private directory to contain employees' contact information.

In addition to the creation of private directories, however, an aspect of the invention allows different levels of access to a private directory to be assigned to different users. In the preferred embodiment, for instance, a read-only user of a private directory has only the right to read the information in the directory; an administrator of a private directory has the right to read and edit the information in the directory, the right to provision new read-only users and the right to remove access privileges from previously provisioned read-only users; an owner of a private directory, normally the creator thereof, has the right to delete the directory, to provision and remove administrators of the directory, and all the rights of an administrator. Page 6, lines 19-27. Thus, in the example above of the individual who created two private directories, that individual may assign his spouse the rights of an administrator for his personal contact private directory, but only "read only" rights to his business private directory. Where a corporation is the owner of private directories, different employees can be given different access rights to these private directories. *See* page 5, line 17 *et seq.* of the specification.

The invention contemplates various ways by which users can access and modify these private directories, such as directly over the Internet using GUIs provided by the directory assistance provider. However, in one aspect of the invention pertinent to the claims on appeal, a user can access private directories by calling an agent, such as a directory assistance operator, who will act as a surrogate for the user. In this capacity, the agent inherits only the access rights

to private directories that the calling user has. For example, if the calling user cannot access a particular private directory, then neither can the agent. If the calling user has read-only rights to another private directory, those are the only rights the agent has. This is preferable to operations in which human agents always have full access rights, and are relied on to disclose to individual callers only the information the callers have the right to access, since such operations are susceptible to human error on the part of the agent. *See* page 6, line 28 *et seq.*; page 12, line 26 *et seq.* of the specification.

2. Brief Overview of Appellant's Claims

Claims 22-25, 28, 29, 41-44, 46-50, 53-54, 66-69, and 71-97 are drawn to a system and method for maintaining data sources, e.g., private directories, through a directory assistance provider. When a user calls the directory assistance provider, the private directories associated with the user may be identified to the directory assistance provider based on the telephone number of the communication apparatus from which the user's call originates (in the preferred embodiment, based on the caller's MIN). The directory assistance provider may receive a request from the user to take an action concerning a selected data source on behalf of the user. The user is allocated one of a plurality of levels of access to the selected data source. The levels of access are associated with different sets of allowed actions concerning the selected data source, respectively. An agent is accorded a level of access to the selected data source as a function of the level of access allocated to the user. The agent is allowed to take the requested action on behalf of the user when the action is within the set of actions associated with the level of access accorded to the agent.

VI. ISSUES PRESENTED FOR REVIEW

1. Whether claims 22-25, 28, 41-44, 46-50, 53, 66-69, and 71-97 are unpatentable under 35 U.S.C. 103(a) as being obvious over U.S. Patent Application Publication No. 2002/0085702 by Cox et al., published July 4, 2002 (hereinafter "Cox"), in view of U.S. Patent No. 5,204,894 issued April 20, 1993 to Darden (hereinafter "Darden"), and further in view of

U.S. Patent Application Publication No. 2002/0078004 by Ambrosini et al., published June 20, 2002 (hereinafter "Ambrosini"), an Examiner example, U.S. Patent No. 6,081,898 issued June 27, 2000 to Miller et al. (hereinafter "Miller"), and U.S. Patent No. 5,574,776 issued November 12, 1996 to Leuca et al. (hereinafter "Leuca").

2. Whether claims 29 and 54 are unpatentable under 35 U.S.C. 103(a) as being obvious over Cox, in view of Darden, Miller, Leuca, and further in view of U.S. Patent No. 6,404,884 issued June 11, 2002 to Marwell et al (hereinafter "Marwell").

VII. GROUPING OF CLAIMS

It is respectfully submitted that system claims 22-25, 28, 29 and 72-77, and method claims 47-50, 53, 54 and 83-88 corresponding thereto are individually patentable over the cited references; and system claims 41-44, 46, 78-82, 94 and 95, and method claims 66-69, 71, 89-93, 96 and 97 corresponding thereto are individually patentable over the cited references. All claims are to be considered separately for purposes of this appeal.

VIII. ARGUMENTS

1. Summary of Arguments

The Examiner rejected claims 22-25, 28, 41-44, 46-50, 53, 66-69, and 71-97 under 35 U.S.C. 103(a) by combining six references comprised of three patents, two published patent applications and an Examiner example. These rejections are improper for at least three fundamental reasons:

- 1) Ambrosini is used by the Examiner as a 35 U.S.C. 103 prior art reference, even though the reference is not prior art to the instant application;
- 2) Assuming *arguendo* that the Examiner's reliance on Ambrosini is proper, there would have been no motivation to combine these references, and the Examiner has not offered any evidence of a motivation to combine. Indeed, if anything, the references teach away from the Examiner's combination; and
- 3) The combination of all six references *still does not produce the claimed invention*.

The Examiner's rejection of claims 29 and 54 is moot, as the Examiner's rejection is based on a previous incarnation of those claims.

2. The Examiner's Reliance on Ambrosini is Improper

(a) The Examiner Has Improperly Relied on Ambrosini as Prior Art

Ambrosini is a published U.S. Patent Application which was filed on December 18, 2000. The filing date of the present application is November 12, 1999. Therefore, Ambrosini is not prior art under 35 U.S.C. 102 or 103.

Implicitly acknowledging this, the Examiner cites *Gould v. Quigg*, 3 U.S.P.Q.2d 1302 (Fed. Cir. 1987) for the proposition that "[m]aterial that is not technically prior art can be relied upon as evidence of the skill level in the art as of about the date of invention, e.g., a later dated publication." Page 4 of the Final Office Action (see Appendix B). The Examiner, however, is not relying on Ambrosini as evidence of the level of skill in the art: he is relying on it as evidence of what is in the prior art. Addressing the limitations of base claims 22, 41, 47 and 66 that "levels of access [are] associated with respective sets of allowed actions" relating to a data source, the Examiner states:

Furthermore, as taught by Ambrosini et al. it is *old and well known* to allocate various levels of access to directory services such as directory assistance . . .

Id. The level of skill in the art relates to questions such as what those of ordinary skill in the art would be capable of implementing when presented with a given problem, what their general educational level was, etc. In the *Gould* case, for example, the issue was whether a specification provided an enabling disclosure, and the non-prior art document was used "as evidence of the level of ordinary skill in the art at the time of the application and as evidence that the disclosed device would have been operative." *Gould* at 1305. This is very different than using a reference as prior art, such as when a reference is relied on (as Ambrosini is relied on by the Examiner) as a 35 U.S.C. 103 reference which allegedly teaches a claim limitation. Because the Examiner is using Ambrosini as a Section 103 prior art reference, his reliance on Ambrosini is improper under 35 U.S.C. 102 and 103.

(b) Ambrosini is not Reliable Evidence of the Level of Ordinary Skill in the Art

Even if the Examiner were to change the nature of his reliance on those portions of Ambrosini he considers relevant, such that he uses them only as evidence of the level of ordinary skill in the art and not as prior art, the reference simply has no indicia of reliability as to what the level of ordinary skill in the art was. Therefore, it is not appropriate to use Ambrosini as evidence of the level or ordinary skill in the art.

The Examiner relies on a brief discussion of a Bellcore F20 Specification (hereinafter “the Bellcore Specification”) in paragraph 39 of Ambrosini to reject the claimed invention. While Ambrosini says that the date of the Bellcore Specification is September 1998, it may not have been a “printed publication” in accordance with Section 102 as of that date, meaning it is possible that even the Bellcore Specification is not prior art. If the Bellcore Specification is not prior art, Ambrosini’s description of it cannot possibly be reliable evidence of what the ordinary level of skill in the art was prior to the invention of the appealed claims. That is, it is inconceivable that a non-prior art reference’s description of another, unavailable non-prior art reference can be reliable evidence of the level of skill those of ordinary skill had prior to the claimed invention. Applicants therefore asked the Examiner, in applicants’ Fifth Amendment, to provide a copy of the Bellcore Specification. *See* Appendix C. The Examiner has not yet responded to this request, even though it is the Examiner’s burden to provide the reference. “[P]ublic accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ *The proponent* [here the Examiner] of the [Section 102] publication bar *must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art.*” *In re Hall*, 228 U.S.P.Q. 453, 455 (Fed. Cir. 1986) (citations omitted).

Ambrosini’s description of the Bellcore Specification is analogous to an abstract of a foreign language reference document. “To determine whether the abstract [of the Bellcore Specification] and the underlying document [i.e., the Bellcore Specification] are prior art, a copy of the underlying document must be obtained and analyzed.” MPEP 706.02 II (emphasis added). In addition, the “abstract” of the Bellcore Specification is written by Ambrosini, not by the author of the Bellcore Specification, and is therefore susceptible to error, as the Board of Patent Appeals and Interferences has itself observed: “[a]bstracts often are not written by the author of

the underlying document and may be erroneous.” *Ex Parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001)(unpublished). “Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.” *Id.* Finally, without the full text document, applicants are denied an opportunity to determine whether the Bellcore Specification “include[s] teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.” MPEP 706.02 II.

For all of the above reasons, it is respectfully requested that the Ambrosini publication be removed as a reference against the claimed invention, and the obviousness rejection in question be withdrawn.

3. The Examiner Has Failed To Establish A *Prima Facie* Case Of Obviousness With Respect To Claims 22-25, 28, 41-44, 46-50, 53, 66-69, and 71-97

Even assuming, *arguendo*, that the application of Ambrosini against the claimed invention is appropriate, the Examiner has still failed to establish a prima facie case of obviousness based on a combination of Ambrosini and five other references, namely, Cox, Darden, Miller, Leuca and an example posited by the Examiner. Not only has the Examiner not provided a motivation to combine these six disparate references, combining all six still does not produce the invention of the appealed claims.

(a) The Examiner’s Combination of Cox and Darden is Improper

The first two references the Examiner combines are Cox and Darden. Cox is directed to a directory assistance system through which a customer may complete a call to a desired destination party. Restrictions on a customer’s authority to complete certain calls, e.g., long distance calls, through a directory assistance system may be imposed. A customer’s identity is established using data concerning the calling telephone number and the location from which the customer’s call originates, which is received along with the customer’s call. Based upon the customer’s identity and stored information concerning restrictions on the customer’s calling authority, the customer’s authorization for connecting to a desired destination party can be verified. *See* paragraph 15 of Cox.

Darden discloses a communications system for a subscriber to create and access his/her own personal electronic directory (PED) via telephone. The PED advantageously replaces a personal directory in written book form usually carried by a person. In accordance with the disclosed technique, a subscriber records, on the communications system, listings in a PED in his/her own voice for subsequent reference thereto. It allows the subscriber not only to store and retrieve, but also change or erase the listings by speaking into the telephone. In order to access the PED, the subscriber needs to dial a designated telephone number and provide the system with a password. Once the password is verified, the subscriber may be prompted to provide a listed name for which the telephone number is desired. The desired telephone number may then be automatically dialed by the system for the subscriber. *See* col. 4, line 64 *et seq.* of Darden.

The Examiner has not identified any evidence of a motivation to combine these references. Although an examiner may formulate an obviousness rejection of a claimed invention based on a combination of prior art references, the examiner is required to provide clear and particular evidence of a suggestion, teaching or motivation to combine such references:

evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases from the nature of the problem to be solved, although "the suggestion more often comes from the teachings of the pertinent references." The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added, citations omitted).

Moreover, if anything, the references themselves teach away from the combination postulated by the Examiner. In the final Office Action, the Examiner stated that although Cox "does teach a caller/subscriber being able to provision certain preferences," it does not explicitly teach the "editing and deletion of a directory or directory information." Darden is then relied on for this teaching. Appendix B, page 3. What the Examiner does not seem to appreciate, however, is that in Cox the directory or directory information used for directory assistance is a standard, public commercial directory, e.g., white pages, and the editing and deletion of entries in a public directory is typically performed by one or more telephone companies. Those skilled

in the art would immediately appreciate that individual callers/subscribers are prohibited from tampering with such standard, public directories. Thus, if anything, Cox actually teaches away from a combination with Darden's personal electronic directory.

Ignoring both his obligation to cite specific evidence of motivation to combine and the fact that the references actually teach away from such a combination, the Examiner relies only on conjecture and speculation as to why the references should be combined, stating that "including such flexibility," i.e., "the creation, editing, deletion, and general manipulation of one's personal directory," "in the system of Cox et al. would be obvious to one skilled in the art inasmuch as Cox et al. already teach being able to access different types of directories and databases." *Id.* The Examiner also states that "the trend of telecommunications has always been and continues to be one which gives the personal user/caller/subscriber more flexibility with their own services, to give them more control." *Id.* at 4. The Examiner further stated that "[i]ncluding a personal, editable directory would simply be extending the [system] of Cox et al. to access just another type of directory and giving the caller/subscriber more authority," "because Cox et al. already teach making certain features of the system programmable/customizable to a specific caller/subscriber." *Id.* at 3-4.

In effect, the Examiner's logic is that because it is always the goal to offer users new capabilities ("the trend of telecommunications has always been and continues to be one which gives the personal user/caller/subscriber more flexibility with their own services, to give them more control"), and because the claimed invention does offer the user new capabilities ("[i]ncluding a personal, editable directory would simply be extending the [system] of Cox et al. to access just another type of directory and giving the caller/subscriber more authority"), the claimed invention is obvious. If this logic were correct, every invention would be obvious, since it is always the "trend" to make improvements in every field of art. In any event, the Examiner's use of broad conclusory statements to support his attempted hindsight reconstruction of the invention is precisely what the Federal Circuit tried to prevent with its mandate for "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d at 999.

(b) The Examiner's Further Combination of Ambrosini to Fill the Admitted Gaps in the Cox/Darden Combination was Also Improper

The Examiner admits that the combination of Cox and Darden does not produce the invention of the claims on appeal. In order to address the limitations in base claims 22, 41, 47 and 66 that "levels of access [are] associated with respective sets of allowed actions" relating to a data source, which is lacking from both Cox and Darden, the Examiner relies on Ambrosini's representation that the Bellcore Specification defines the different ways a person can have his number listed in a telephone directory ("Emergency non-published," "Privacy," "Nonlisted," "Non-published," and "Normal.") The Examiner concludes from this that "it is old and well known to allocate various levels of user access to information in directory assistance," and that "[t]here must be some data source where users can be identified as having those different levels of access." Appendix B, page 4 (emphasis added).

The holes in this analysis are legion. In the first instance, Ambrosini says only that the Bellcore specification discloses the way telephone numbers can be listed in public telephone directories used for directory assistance. This not only doesn't suggest that "users can be identified as having [] different levels of access," it affirmatively suggest that users cannot be so identified. For example, we all know that once we designate our telephone number as "unlisted," it is "unlisted" for all the users in the world. The capability did not exist to say a telephone number is unlisted for some designated people but not unlisted for other designated people, and nothing in Ambrosini suggests that such a capability did exist. Therefore, it is simply not true, as the Examiner speculated, that "[t]here must be some data source where users can be identified as having those different levels of access."

Moreover, the Examiner again provides no evidence as to the motivation to further combine Ambrosini. More specifically, he provides no explanation as to what the motivation would be to combine Ambrosini, which describes security levels applicable to individual listings in a public database, with Darden, where listings are entered by a user for his/her own personal consumption and where security levels such as "Emergency non-published," "Privacy," "Nonlisted," "Non-published" and "Normal" would make no sense.

(c) The Examiner's Final Combination of an Examiner Example, Miller and Leuca is Improper and Still Does Not Produce the Claimed Invention

Even assuming *arguendo* that it is proper to combine Cox, Darden, and Ambrosini, and further assuming *arguendo* that these references teach what the Examiner says they teach (both propositions having been demonstrated to be false above), the Examiner admits that the combination of these three references still does not produce the claimed invention. The Examiner confirmed this both in his Final Office Action, where he states that "Cox et al. and Darden also do not teach the use of an intermediate agent that acts on behalf of the initiator, wherein that agent is accorded the level of access the initiator has," and in an interview dated December 22, 2003, which the Examiner summarized as follows:

[The parties d]iscussed the difference between the prior art and claimed invention as being the existence of an intermediary function acting between a directory assistance initiator and the actual directory assistance system. Examiner suggested drawing the claims to highlight this aspect of the claimed invention, wherein the intermediary function assumes the same access level as an initiator automatically or some level as function thereof. Such a limitation, if one could be developed, would overcome the prior art references presented thusfar.

Appendix D, page 3.

The applicants complied with the Examiner's suggestion, and amended base claims 22, 41, 47 and 66 to further incorporate the "intermediary" aspect of the invention. *See* Appendix C. For example, applicants amended claim 22 to recite that the initiator's request for taking an action "on behalf of the initiator" concerning a selected data source associated with the initiator is communicated to "an agent for taking the action on behalf of the initiator." Claim 22 was further amended to specify that "the agent [is] accorded a level of access to the selected data source" which is "a function of" the initiator's level of access, and that "the agent is allowed to take the action on behalf of the initiator when the action is within the set of actions associated with the level of access accorded to the agent." Claims 41, 47, and 66 were amended in a similar manner.

The Examiner attempts to fill this substantial gap in the Cox/Darden/Ambrosini combination by relying three new references: one examiner example and the Miller and Leuca

patents. None of them, however, either alone or in combination, teach or suggest an agent being accorded a level of access to a data source as a function of the initiator's level of access.

The following is the example relied on by the Examiner:

A secretary [at the USPTO] who handles the incoming telephone calls is used basically to screen calls and could decide to connect a person to the Director without giving that person the actual/direct telephone number of the Director....

However, such is at the least obvious in many directory assistance systems as can be seen in the above discussion regarding an example of what happens [sic] what one calls a business employee such as the Director of the USPTO. In this example, the secretary would be analogous to the claimed agent taking the action on behalf of the initiator. Of course, if an outside caller is an initiator, the secretary, as discussed above will connect the call, but not give out a direct number. If, however, the Director himself called, asking for the telephone number of a USPTO employee, this secretary would be able to relay that number to him. As an employee, the Director would have more access to the employee directory than an outside caller.¹

Appendix B, pages 4-5. The Examiner has thus taken official notice of a method (without substantiating it with references or other evidence), and then relied on that method as a reference in a Section 103 combination. Not only should use of official notice be "rare" in final office actions, "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." "[A]n assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support." MPEP 2144.03. The Examiner's use of this official notice was thus improper. If the example is based on the Examiner's personal knowledge that this method was performed in the prior art, the Examiner needs to provide an affidavit to that effect on the record.

Even assuming *arguendo* that the Examiner's example is in the prior art, it still has no applicability to the claims on appeal. According to the example, a secretary of the USPTO, who himself has access to the entire USPTO internal directory, will give out employee telephone

¹ The Examiner relied on a similar example to overcome Cox and Darden's failure "to teach connecting an initiator to the selected data element even if disclosure is prohibited." Appendix B, page 4. The Examiner did not realize, however, that this "connecting" limitation is no longer in any of the pending claims.

numbers to callers who are also USPTO employees but will not give out such numbers to other callers. This example completely fails to teach or suggest, among other things, an agent “being accorded a level of access” to a data source “as a function” of the initiator’s level of access, as required by claims 22, 41, 47, and 66. The secretary in the Examiner’s example always has the same level of access to the telephone numbers in the USPTO directory, whether the caller is an employee of the USPTO or not. The method of the Examiner’s example relies on the fact that the secretary will always assiduously follow USPTO policy regarding who is entitled to have employee telephone numbers and who is not, a method which is fraught with the possibility of human error, especially as the different levels of access, different sets of allowed actions, different classes of users and different types of data increase.

The Examiner cites two additional references, Miller and Leuca, which allegedly teach or suggest the “intermediate agent” aspect of the invention. Miller discloses a technique for resolving security issues created by treating both files and directory service entries as objects in an operating system. Directory services entries are stored in the name space of the file system and provide the name service for the file system. In accordance with the Miller technique, protection of directory service entries is realized by prohibiting a client (e.g., a computer or software application) from accessing the directory service entries directly. Rather, a remote agent, called via a remote procedure call, receives all requests from clients which, in turn, accesses directory service entries for the clients. Access control lists (ACLs) are used to control which clients can access a directory service entry and for what purpose. *See col. 7, line 1 et seq.* of Miller.

However, nowhere does Miller teach or suggest that the initiator is “allocated one of a plurality of levels of access to the selected data source,” which is “associated with the initiator,” as recited in claim 22. By contrast, there are no data sources in Miller which are specifically associated with any initiator, and no initiators have specific levels of access with respect to specific data sources. In addition, Miller fails to teach or suggest an agent “being accorded a level of access to the data source” as a function of the initiator’s level of access, as also recited in claim 22. In fact, the agent in Miller, which is a call routine, is analogous to a secretary screening a call in the Examiner’s example. The agent in Miller always has full access to directory service entries, and follows the ACLs to service calling clients. Other base claims 41,

47 and 66 include similar limitations to claim 22 discussed above. Indeed, the Examiner seems to admit these key features are missing from Miller when he concludes that “differing levels of access to directory systems is known and would be applied here as well.” Appendix B, page 6.

Leuca discloses a service for providing access for hearing-impaired users to a telecommunications network. Specifically, a user of a text telephone device (TDD) initiates a telephone call, and is connected to a relay service, where a service attendant performs a translation function, i.e., translating speech into text for delivery to the user’s TDD and translating text from the user’s TDD into speech for delivery to the destination party. *See* col. 3, line 10 *et seq.* of Leuca.

However, Leuca also fails to teach or suggest, among other things, an “agent being accorded a level of access” to a data source “as a function” of the initiator’s level of access, as recited in base claims 22, 41, 47, and 66. Again, the Examiner appears to concede this, asserting that “of course, as already discussed above, security and differing levels of access would also be obvious if not inherent in this situation as well.” Appendix B, page 6. In fact, Leuca at best discloses a relay service for a TDD user so that such a user would “have the same level of access to a telecommunications network as a nonTDD user.” Col. 1, line 35 *et seq.* of Leuca. Thus, Leuca addresses a problem relating to ease of access by a TDD user to a telecommunications network relative to a nonTDD user. It is immediately apparent that the “ease of access” addressed by Leuca is a completely different concept than the “access rights” to which the present invention is directed.

Because the Examiner’s combination of Cox, Darden, Ambrosini, the Examiner’s example, Miller and Leuca is improper, and because, even as combined, this combination does not teach the invention of the appealed claims, the Examiner’s rejections should be reversed.

4. The Examiner’s Rejection Of Claims 29 and 54 Is Moot

The Examiner rejected claims 29 and 54 under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Darden, Miller, Leuca and further in view of Marwell. According to the Examiner, “Marwell et al. teach accessing and manipulating a personal contact list, which is analogous to the above-discussed personal directory, via the web.” The Examiner failed to

realize, however, that applicants had amended claims 29 and 54, and these claims are no longer directed to an "initiator establishing an internet connection." The Examiner's rejection of these claims is therefore moot.²

IX. SUMMARY

Because the Examiner erroneously applied Ambrosini against the claimed invention and improperly combined Cox, Darden, Ambrosini, the Examiner's example, Miller and Leuca in an attempt to reconstruct the invention using hindsight, and because this combination still does not yield the claimed invention represented by claims 22-25, 28, 41-44, 46-50, 53, 66-69, and 71-97, applicants respectfully request that the Examiner's rejection of these claims be reversed. In addition, because the basis for the Examiner's rejection of claims 29 and 54 has already been rendered moot, applicants respectfully request that the rejection of these claims be reversed as well.

Respectfully submitted,

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Michael A. Kepler
Michael Essex
John S. Stafford

By: 

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Attorney for Applicants
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Date: August 24, 2004

Kaye Scholer LLP
425 Park Avenue
New York, NY 10022-3598

² Applicants do not concede that the Examiner's characterization of Marwell is accurate or that Marwell is in fact prior art.

CLAIMS ON APPEAL

22. A system for maintaining data sources through a directory assistance provider comprising:

an interface for receiving signals in establishing a communication connection with the directory assistance provider, the communication connection being initiated by an initiator using a communications apparatus, one or more data sources which are associated with the initiator being identified to the directory assistance provider based on an identifier in the received signals which identifies the communications apparatus;

a receiver for receiving from the initiator a request for taking an action concerning a selected one of the data sources on behalf of the initiator, the initiator being allocated one of a plurality of levels of access to the selected data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the selected data source, the request being communicated to an agent for taking the action on behalf of the initiator, the agent being accorded a level of access to the selected data source, the level of access accorded to the agent being a function of the level of access allocated to the initiator; and

a processor for determining that the agent is allowed to take the action on behalf of the initiator when the action is within the set of actions associated with the level of access accorded to the agent.

23. The system of claim 22 wherein the selected data source includes information concerning an individual.

24. The system of claim 22 wherein the selected data source includes information concerning a group.

25. The system of claim 22 wherein the selected data source includes contact information.

28. The system of claim 22 wherein the communication connection includes a telephone connection.

29. The system of claim 28 wherein the identifier includes a telephone number.

41. A system for use by a provider of a communications service comprising:
at least one data source associated with a user, the data source being searchable for contact information concerning a desired party based on which the provider establishes a communication connection to the desired party for the user, the user being allocated one of a plurality of levels of access to the data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the data source;

an interface for receiving a call by the user to the provider, the call including a request for taking an action concerning the data source on behalf of the user, based on at least an identifier associated with the call the data source being identified to an agent for taking the action on behalf of the user, the agent being accorded a level of access to the data source, the level of access accorded to the agent being a function of the level of access allocated to the user; and

a controller for allowing the agent to take the action on behalf of the user when the action is within the set of actions associated with the level of access accorded to the agent.

42. The system of claim 41 wherein the communications service includes a voice communications service.

43. The system of claim 41 wherein the data source includes a directory.

44. The system of claim 43 wherein the communications service includes a directory assistance service.

46. The system of claim 41 wherein the communication connection includes a telephone connection.

47. (currently amended) A method for maintaining data sources through a directory assistance provider comprising:

receiving signals in establishing a communication connection with the directory assistance provider, the communication connection being initiated by an initiator using a communications apparatus, one or more data sources which are associated with the initiator being identified to the directory assistance provider based on an identifier in the received signals which identifies the communications apparatus;

receiving from the initiator a request for taking an action concerning a selected one of the data sources on behalf of the initiator, the initiator being allocated one of a plurality of levels of access to the selected data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the selected data source, the request being communicated to an agent for taking the action on behalf of the initiator, the agent being accorded a level of access to the selected data source, the level of access accorded to the agent being a function of the level of access allocated to the initiator; and

determining that the agent is allowed to take the action on behalf of the initiator when the action is within the set of actions associated with the level of access accorded to the agent.

48. The method of claim 47 wherein the selected data source includes information concerning an individual.

49. The method of claim 47 wherein the selected data source includes information concerning a group.

50. The method of claim 47 wherein the selected data source includes contact information.

53. The method of claim 47 wherein the communication connection includes a telephone connection.

54. The method of claim 47 wherein the identifier includes a telephone number.

66. A method for use by a provider of a communications service comprising:
maintaining at least one data source associated with a user, the data source being searchable for contact information concerning a desired party based on which the provider establishes a communication connection to the desired party for the user, the user being allocated one of a plurality of levels of access to the data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the data source;

receiving a call by the user to the provider, the call including a request for taking an action concerning the data source on behalf of the user, based on at least an identifier associated with the call the data source being identified to an agent for taking the action on behalf of the user, the agent being accorded a level of access to the data source, the level of access accorded to the agent being a function of the level of access allocated to the user; and

allowing the agent to take the action on behalf of the user when the action is within the set of actions associated with the level of access accorded to the agent.

67. The method of claim 66 wherein the communications service includes a voice communications service.

68. The method of claim 66 wherein the data source includes a directory.

69. The method of claim 68 wherein the communications service includes a directory assistance service.

71. The method of claim 66 wherein the communication connection includes a telephone connection.

72. The system of claim 22 wherein the action includes revising data elements in the data source.

73. The system of claim 22 wherein the action includes deleting data elements in the data source.

74. The system of claim 22 wherein the action includes adding data elements to the data source.

75. The system of claim 22 wherein the level of access allocated to the initiator allows the initiator to only view selected data elements in the data source.

76. The system of claim 22 wherein the agent includes an operator.

77. The system of claim 22 wherein the agent includes a voice server.

78. The system of claim 41 wherein the identifier includes a telephone number from which the call originates.

79. The system of claim 41 wherein the action includes revising data elements in the data source.

80. The system of claim 41 wherein the action includes deleting data elements in the data source.

81. The system of claim 41 wherein the action includes adding data elements to the data source.

82. The system of claim 41 wherein the level of access allocated to the user allows the user to only view selected data elements in the data source.

83. The method of claim 47 wherein the action includes revising data elements in the data source.

84. The method of claim 47 wherein the action includes deleting data elements in the data source.

85. The method of claim 47 wherein the action includes adding data elements to the data source.

86. The method of claim 47 wherein the level of access allocated to the initiator allows the initiator to only view selected data elements in the data source.

87. The method of claim 47 wherein the agent includes an operator.

88. The method of claim 47 wherein the agent includes a voice server.

89. The method of claim 66 wherein the identifier includes a telephone number from which the call originates.

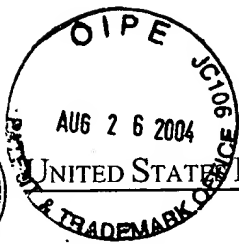
90. The method of claim 66 wherein the action includes revising data elements in the data source.

91. The method of claim 66 wherein the action includes deleting data elements in the data source.

92. The method of claim 66 wherein the action includes adding data elements to the data source.

93. The method of claim 66 wherein the level of access allocated to the user allows the user to only view selected data elements in the data source.

94. The system of claim 41 wherein the agent includes an operator.
95. The system of claim 41 wherein the agent includes a voice server.
96. The method of claim 66 wherein the agent includes an operator.
97. The method of claim 66 wherein the agent includes a voice server.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,656	11/12/1999	NICHOLAS J. ELSEY	1631077-0028 <i>41698-1012</i>	4745
7590 03/25/2004			EXAMINER	
Alex L Yip Kaye Scholer Fierman Hays & Handler LLP 425 Park Avenue New York, NY 10022			AGDEPPA, HECTOR A	
			ART UNIT	PAPER NUMBER
			2642	
			DATE MAILED: 03/25/2004	<i>25</i>

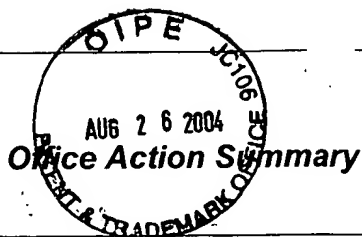
Please find below and/or attached an Office communication concerning this application or proceeding.

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AUG 3 1 2004

Technology Center 2600

File No.: *41698-1012*
3 Month Date: *6/25/04*
6 Month Date: *9/25/04*
DOCKETED
Date: *4-12-04*
By: *MA*



Application No.

09/441,656

Applicant(s)

ELSEY ET AL.

Examiner

Hector A. Agdeppa

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

RECEIVED**Status**

AUG 31 2004

Technology Center 2600

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 - 25, 28, 29, 41 - 44, 46 - 50, 53, 54, 66 - 69, 71 - 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 - 25, 28, 29, 41 - 44, 46 - 50, 53, 54, 66 - 69, 71 - 97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on 12/29/03. Claims 22 – 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 - 97 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 22 – 25, 28, 41 – 44, 46 - 50, 53, 66 – 69, 71 – 75, 78 – 86, and 89 – 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden) and further in view of US Pat Pub 2002/0078004 (Ambrosini et al.), US 6,081,898 (Miller et al.) and US 5,574,776 (Leuca et al.)

As to claims 22, 41, 47, and 66, Cox et al. teach a method and apparatus for providing directory assistance wherein an initiator of the communication connection is

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associated with various data elements as claimed, those elements being either ANI, area of the caller's origination, the caller's identity, etc. and is identified based on that data. Of course with data elements such as those noted, it is inherent that there must be a data source where such elements can be stored and accessed. Furthermore, depending on the type of service the caller desires, whether it be retrieval of a desired telephony number or the leaving of a message or the paging of an unreachable destination party, the caller's right to access or have that particular service performed is first verified. If the caller is verified and has the authority to make the desired call, receive/use the desired information, the appropriate actions are taken. (Page 1, paragraphs 0004 – 0005 and 0008, Page 2, paragraphs 0012 – 0016, Page 3, paragraphs 0036, Page 4, paragraph 0044 – Page 7, paragraph 0072)

Cox et al. has been discussed above but does not teach explicitly the editing and deletion of a directory or directory information, although Cox et al. does teach a caller/subscriber being able to provision certain preferences.

However, Darden teaches a personal electronic directory allowing or the creation, editing, deletion, and general manipulation of one's personal directory. Including such flexibility in the system of Cox et al. would be obvious to one skilled in the art inasmuch as Cox et al. already teach being able to access different types of directories and databases. Including a personal, editable directory would simply be extending the invention of Cox et al. to access just another type of directory and giving the caller/subscriber more authority. Again, because Cox et al. already teach making certain features of the system programmable/customizable to a specific

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caller/subscriber, such would be obvious to one skilled in the art. Lastly, the trend of telecommunications has always been and continues to be one which gives the personal user/caller/subscriber more flexibility with their own services, to give them more control. Such reasoning too would make it obvious to combine the teachings of Cox et al. and Darden. (Abstract, Col. 2, lines 39 – Col. 3, line 50, Col. 5, line 8 – Col. 10, line 26 of Darden)

Furthermore, as taught by Ambrosini et al. it is old and well known to allocate various levels of access to directory services such as directory assistance wherein the different levels of user access to information in directory assistance are defined in the Bellcore F20 Specification (BR 754-110-103, Issue 8, September 1998, Rev. 1, March 1991). (P. 4, ¶ 0039 of Ambrosini et al.) Also allocating different levels of access to directories can even be seen various computer arts wherein certain file directories or folders are given different levels of access. As mentioned above, the data source is inherent in such a system and would also be inherent in any system having different levels of access. There must be some data source where users can be identified as having those different levels of access. Material that is not technically prior art can be relied upon as evidence of the skill level in the art as of about the date of invention, e.g., a later dated publication, *Gould v. Quigg*, 3 USPQ2d 1302 (Fed. Cir. 1987).

Furthermore, Cox et al. and Darden do not teach connecting an initiator to the selected data element even if disclosure is prohibited.

However, such is a very old and common procedure. An example of this would arise when calling the Director of the USPTO. A secretary who handles the incoming

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telephone calls is used basically to screen calls and could decide to connect a person to the Director without giving that person the actual/direct telephone number of the Director. If one merely calls a corporation and asks for a telephone number of an employee, many times, the operator will not give out the telephone number but will agree to connect the person. This is done for many reasons. One is simply because, if the desired telephone number was given out, there would be no way to screen callers since they could call at anytime bypassing the operator or secretary. This is a common motivation and would have been an obvious feature to include in the invention of Cox et al. by one of ordinary skill in the art.

Cox et al. and Darden also do not teach the use of an intermediate agent that acts on behalf of the initiator, wherein that agent is accorded the level of access the initiator has.

However, such is at the least obvious in many directory assistance systems as can be seen in the above discussion regarding an example of what happens what one calls a business employee such as the Director of the USPTO. In this example, the secretary would be analogous to the claimed agent taking the action on behalf of the initiator. Of course, if an outside caller is the initiator, the secretary, as discussed above will connect the call, but not give out a direct number. If however, the Director himself called, asking for the telephone number of a USPTO employee, the secretary would be able to relay that number to him. As an employee, the Director would have more access to the employee directory than an outside caller.

Another example of an intermediate agent is taught by Miller et al. wherein a requesting party must demonstrate knowledge of a shared secret to gain access to directory service entries via a remote agent acting on behalf of the requesting party. (Col. 6, lines 66 – Col. 7, line 19 of Miller et al.) Of course, as discussed above, differing levels of access to directory systems is known and would be applied here as well. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have implemented such a feature in Cox et al. and Darden simply because security is a common motivation as is remote access to information services.

Another example, in a different circumstance, is taught by Leuca et al. In the realm of text telephone devices (TDD) and the hearing impaired, intermediate agents is an old and well known method of operation. Leuca et al. teaches that for a hearing impaired person to access a service such as directory assistance, a relay service, wherein the relay service is an unimpaired agent or operator that can act on behalf of the hearing impaired initiator. (Col. 1, lines 15 – 34 of Leuca et al.) Again, of course, as already discussed above, security and differing levels of access would also be obvious if not inherent in this situation as well. And again, it would have been obvious for one of ordinary skill in the art to have employed such functionality in the system of Cox et al. and Darden, inasmuch as in one sense, such functionality could be implemented as a front-end, merely controlling access, so that a hearing impaired person could access the directory assistance system of Cox et al.

Moreover, the levels of access will always be a function of the level of access of the initiator as discussed above, because the operator will always have ultimate access to the entire directory, whereas the initiator, depending on his/her access level will not.

As to claims 23 – 25 and 48 – 50, Cox et al. teach a directory assistance means and method wherein the information sought by the caller is information concerning an individual such as a telephone number or address or even groups such as information regarding/coming from business directories as opposed to private individuals.

Moreover, inherent in Cox et al. or any other directory assistance system for that matter is reading the selected data element, otherwise there would be no other way to ascertain the data and present it to the caller or even simply to retrieve it, the data element must be read. And of course as already mentioned accessing a data source where those data elements are stored and accessed (See above references to Cox et al.)

As to claims 28, 42 – 44, 46, 53, 67 – 69, and 71, of course the communications service would include a voice communications service as taught by Cox et al. The present invention as well as Cox et al. and most any other standard directory assistance means and method would have to include a communications service that included making a telephone connection. Simply getting access to the directory assistance system would entail having to use a voice communications system and having to make a telephone connection. Moreover, see Fig. 1 and Data servers 120a for example which are analogous to the claimed "database[s] includ[ing] a directory." As already discussed above, the invention of Cox et al. is a directory assistance system. As also

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discussed above, Cox et al. teach verifying the authority of a caller to access certain desired information and/or to have those calls completed by the directory assistance system. (See above references to Cox et al.)

As to claims 76, 77, 87, 88, and 94 – 97, see P. 6, ¶ 0064 of Cox wherein it is explicitly taught that either a live operator or voice server may be used.

3. Claims 29 and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden), US 6,081,898 (Miller et al.), US 5,574,776 (Leuca et al.) and further in view of US Pat 6,404,884 (Marwell et al.)

The cited prior art references have been discussed above, but do not discuss the initiator establishing an internet connection. However, telephony and the internet are well known to now be blended in this and many other types of art. Telephone calls can be made via the internet, call centers may be accessed using both a computer/internet and a standard POTS telephone. Inasmuch as this is the case, it would have been very obvious for one skilled in the art to have allowed access to the claimed present system via the internet. Many services operate this way presently as it just is another way of accessing the service and nothing more. Moreover, Marwell et al. teach accessing and manipulating a personal contact list, which is analogous to the above-discussed personal directory, via the web. (Abstract, Figs. 5 – 13, Col. 5, line 9 – 24 of Marwell et al.)

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Also, the above-mentioned ANI data element is essentially a calling party's telephone number.

Response to Arguments

4. Applicant's arguments with respect to claims 22 – 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 – 93 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

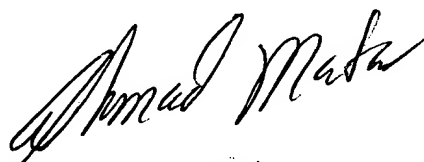
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.
March 19, 2004


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700

Notice of References Cited

AUG 26 2004

Application/Control No.

09/441,656

Applicant(s)/Patent Under

Reexamination

ELSEY ET AL.

Examiner

Hector A. Agdeppa

Art Unit

2642

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,574,776	11-1996	Leuca et al.	379/127.01
	B	US-6,081,898	06-2000	Miller et al.	713/201
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 3 1 2004

Technology Center 2600

Patent Application

Inventor(s) N. Elsey et al.

Case 41698.1012

Serial No. 09/441,656

Examiner A. Hector

Filing Date November 12, 1999

Group Art Unit 2642

Title Enhanced Directory Assistance Service Providing Individual or Group Directories

FIFTH AMENDMENT

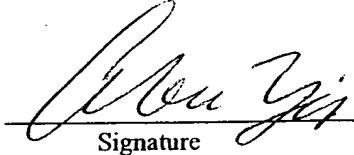
I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 23, 2003.

Alex L. Yip

Attorney Name

34,759

Registration No.


Signature

December 23, 2003

Date of Signature

**THE COMMISSIONER OF PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Sir:

In response to the Office Action dated September 30, 2003, applicants amend the application as follows:

Serial No. 09/441,656

IN THE CLAIMS

Claims 1-21 (cancelled).

22. (currently amended) A system for maintaining data sources through a directory assistance provider comprising:

an interface for receiving signals in establishing a communication connection with the directory assistance provider, the communication connection being initiated by an initiator using a communications apparatus, one or more data sources which are associated with the initiator being identified to the directory assistance provider based on an identifier in the received signals which identifies the communications apparatus;

a receiver for receiving from the initiator a request for taking an action concerning a selected one of the data sources on behalf of the initiator, the initiator being allocated one of a plurality of levels of access to the selected data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the selected data source, the request being communicated to an agent for taking the action on behalf of the initiator, the agent ~~directory assistance provider~~ being accorded a level of access to the selected data source, the level of access accorded to the agent being as a function of the level of access allocated to the initiator; and

a processor for determining that the ~~directory assistance provider~~ agent is allowed to take the action on behalf of the initiator when the action is within the set of actions

Serial No. 09/441,656

associated with the level of access accorded to the agent ~~directory assistance~~ provider.

23. (previously presented) The system of claim 22 wherein the selected data source includes information concerning an individual.

24. (previously presented) The system of claim 22 wherein the selected data source includes information concerning a group.

25. (previously presented) The system of claim 22 wherein the selected data source includes contact information.

Claims 26 and 27 (cancelled).

28. (previously presented) The system of claim 22 wherein the communication connection includes a telephone connection.

29. (previously presented) The system of claim 28 wherein the identifier includes a telephone number.

Claims 30-40 (cancelled).

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41. (currently amended) A system for use by a provider of a communications service comprising:

at least one data source associated with a user, the data source being searchable for contact information concerning a desired party based on which the provider establishes a communication connection to the desired party for the user, the user being allocated one of a plurality of levels of access to the data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the data source[[,]] ~~the provider being accorded a level of access to the data source as a function of the level of access allocated to the user;~~

an interface for receiving a call by the user to the provider, the call including a request for taking an action concerning the data source on behalf of the user, based on at least an identifier associated with the call the data source being identified to the provider ~~based on an identifier associated with the call~~ an agent for taking the action on behalf of the user, the agent being accorded a level of access to the data source, the level of access accorded to the agent being a function of the level of access allocated to the user; and

a controller for allowing the agent provider to take the action on behalf of the user when the action is within the set of actions associated with the level of access accorded to the agent provider.

42. (previously presented) The system of claim 41 wherein the communications

Serial No. 09/441,656

service includes a voice communications service.

43. (previously presented) The system of claim 41 wherein the data source includes a directory.

44. (previously presented) The system of claim 43 wherein the communications service includes a directory assistance service.

Claim 45 (cancelled).

46. (previously presented) The system of claim 41 wherein the communication connection includes a telephone connection.

47. (currently amended) A method for maintaining data sources through a directory assistance provider comprising:

receiving signals in establishing a communication connection with the directory assistance provider, the communication connection being initiated by an initiator using a communications apparatus, one or more data sources which are associated with the initiator being identified to the directory assistance provider based on an identifier in the received signals which identifies the communications apparatus;

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receiving from the initiator a request for taking an action concerning a selected one of the data sources on behalf of the initiator, the initiator being allocated one of a plurality of levels of access to the selected data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the selected data source, the request being communicated to an agent for taking the action on behalf of the initiator, the ~~directory assistance provider~~ agent being accorded a level of access to the selected data source, the level of access accorded to the agent being as a function of the level of access allocated to the initiator; and

determining that the ~~directory assistance provider~~ agent is allowed to take the action on behalf of the initiator when the action is within the set of actions associated with the level of access accorded to the ~~directory assistance provider~~ agent.

48. (previously presented) The method of claim 47 wherein the selected data source includes information concerning an individual.

49. (previously presented) The method of claim 47 wherein the selected data source includes information concerning a group.

50. (previously presented) The method of claim 47 wherein the selected data source includes contact information.

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Claims 51 and 52 (cancelled).

53. (previously presented) The method of claim 47 wherein the communication connection includes a telephone connection.

54. (previously presented) The method of claim 47 wherein the identifier includes a telephone number.

Claims 55-65 (cancelled).

66. (currently amended) A method for use by a provider of a communications service comprising:

maintaining at least one data source associated with a user, the data source being searchable for contact information concerning a desired party based on which the provider establishes a communication connection to the desired party for the user, the user being allocated one of a plurality of levels of access to the data source, the plurality of levels of access being associated with respective sets of allowed actions concerning the data source[[,]] ~~the provider being accorded a level of access to the data source as a function of the level of access allocated to the user;~~

receiving a call by the user to the provider, the call including a request for taking

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an action concerning the data source on behalf of the user, based on at least an identifier associated with the call the data source being identified to an agent for taking the action on behalf of the user, the agent being accorded a level of access to the data source, the level of access accorded to the agent being a function of the level of access allocated to the user ~~the provider based on an identifier associated with the call; and~~

allowing the agent provider to take the action on behalf of the user when the action is within the set of actions associated with the level of access accorded to the agent provider.

67. (previously presented) The method of claim 66 wherein the communications service includes a voice communications service.

68. (previously presented) The method of claim 66 wherein the data source includes a directory.

69. (previously presented) The method of claim 68 wherein the communications service includes a directory assistance service.

Claim 70 (cancelled).

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71. (previously presented) The method of claim 66 wherein the communication connection includes a telephone connection.

72. (previously presented) The system of claim 22 wherein the action includes revising data elements in the data source.

73. (previously presented) The system of claim 22 wherein the action includes deleting data elements in the data source.

74. (previously presented) The system of claim 22 wherein the action includes adding data elements to the data source.

75. (previously presented) The system of claim 22 wherein the level of access allocated to the initiator allows the initiator to only view selected data elements in the data source.

76. (currently amended) The system of claim 22 wherein the agent directory assistance provider includes an operator.

77. (currently amended) The system of claim 22 wherein the agent directory

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~~assistance provider~~ includes a voice server.

78. (previously presented) The system of claim 41 wherein the identifier includes a telephone number from which the call originates.

79. (previously presented) The system of claim 41 wherein the action includes revising data elements in the data source.

80. (previously presented) The system of claim 41 wherein the action includes deleting data elements in the data source.

81. (previously presented) The system of claim 41 wherein the action includes adding data elements to the data source.

82. (previously presented) The system of claim 41 wherein the level of access allocated to the user allows the user to only view selected data elements in the data source.

83. (previously presented) The method of claim 47 wherein the action includes revising data elements in the data source.

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84. (previously presented) The method of claim 47 wherein the action includes deleting data elements in the data source.

85. (previously presented) The method of claim 47 wherein the action includes adding data elements to the data source.

86. (previously presented) The method of claim 47 wherein the level of access allocated to the initiator allows the initiator to only view selected data elements in the data source.

87. (currently amended) The method of claim 47 wherein the agent directory ~~assistance provider~~ includes an operator.

88. (currently amended) The method of claim 47 wherein the agent directory ~~assistance provider~~ includes a voice server.

89. (previously presented) The method of claim 66 wherein the identifier includes a telephone number from which the call originates.

90. (previously presented) The method of claim 66 wherein the action includes

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revising data elements in the data source.

91. (previously presented) The method of claim 66 wherein the action includes deleting data elements in the data source.

92. (previously presented) The method of claim 66 wherein the action includes adding data elements to the data source.

93. (previously presented) The method of claim 66 wherein the level of access allocated to the user allows the user to only view selected data elements in the data source.

94. (new) The system of claim 41 wherein the agent includes an operator.

95. (new) The system of claim 41 wherein the agent includes a voice server.

96. (new) The method of claim 66 wherein the agent includes an operator.

97. (new) The method of claim 66 wherein the agent includes a voice server.

REMARKS

Applicants would like to extend their sincere thanks to the Examiner for conducting the telephonic interview on December 22, 2003.

Pursuant to the interview, applicants have amended independent claims 22, 41, 47, and 66 to more clarify the existence of an "intermediary" acting between the initiator of a directory assistance call and a directory assistance provider as suggested by the Examiner. *See* Interview Summary. For example, amended claim 22 now recites that the initiator's request "for taking an action ... on behalf of the initiator" is communicated to "an agent for taking the action on behalf of the initiator," and "the agent is allowed to take the action on behalf of the initiator when the action is within the set of actions associated with the level of access accorded to the agent," which is "a function of the level of access allocated to the initiator." The Examiner agreed that claim 22, as amended, and other similarly amended claims would be patentable over the prior art of record including Cox, Darden, and Ambrosini.

However, Ambrosini is not prior art under 35 U.S.C. 102. The filing date of the Ambrosini application is December 18, 2000. The applicants' filing date (November 12, 1999) pre-dates the Ambrosini reference. As such, it is respectfully requested that Ambrosini be removed from the record as a prior art reference.

The Examiner rejected the claimed invention, asserting that Ambrosini discloses allocating levels of access as in the claimed invention, which assertion is incorrect in the

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first place. Specifically, the Examiner's rejection is premised on the Bellcore F20 Specification (the "Bellcore Specification") discussed in paragraph 39 of Ambrosini. Applicants strongly disagree with this basis for rejection on several grounds. First, the rejection appears to be based on material found in the Bellcore Specification; however, applicants were not provided a copy of the Bellcore Specification, which may not be a "printed publication" under 35 U.S.C. 102. Second, the Examiner's rejection is premised upon Ambrosini's interpretation of selected content of the Bellcore Specification, which may have been taken out of context, let alone whether Ambrosini's interpretation of the selected content is accurate. If the Examiner believes that the Bellcore document is valid prior art, it is respectfully requested that a copy of the document be provided, without depriving applicants of the opportunity to fully address the rejection on the merits.

Claims 29 and 54 were also rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Darden and further in view of Marwell. Applicants do not admit that Marwell is prior art. In any event, the claimed invention represented by claims 29 and 54 is patentable over the cited references by virtue of their dependency from amended claims 22 and 47, respectively, which are patentable for the reasons set forth above.

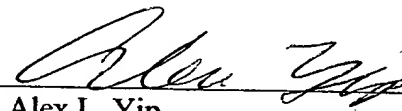
Dependent claims 94-97 have been added, which are drawn to various aspects of the claimed invention.

In view of the foregoing, each of claims 22-25, 28-29, 41-44, 46-50, 53-54, 66-69

Serial No. 09/441,656

and 71-93, as amended, and claims 94-97, as added, is believed to be in condition for allowance. Accordingly, reconsideration of these claims is requested and allowance of the application is earnestly solicited.

Respectfully,

By 
Alex L. Yip
Attorney for Applicants
Reg. No. 34,759
212-836-7363

Date: December 23, 2003

Interview Summary	Application No.		Applicant(s)		
	09/441,656		ELSEY ET AL.		
	Examiner		Art Unit		
	Hector A. Agdeppa		2642		

All participants (applicant, applicant's representative, PTO personnel):

(1) Hector A. Agdeppa. (3) Alex Yip.

(2) Jonathan Tyler. (4) _____

Date of Interview: 22 December 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____

Claim(s) discussed: 22.

Identification of prior art discussed: 2002/0078004 (Ambrosini et al.).

Agreement with respect to the claims f) ☐ was reached g) ☐ was not reached h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation Sheet (PTOL-413)

Application No. 09/441,656

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed the difference between the prior art and claimed invention as being the existence of an intermediary function acting between a directory assistance initiator and the actual directory assistance system. Examiner suggested drawing the claims to highlight this aspect of the claimed invention, wherein the intermediary function assumes the same access level as an initiator automatically or some level as function thereof. Such a limitation, if one could be developed, would overcome the prior art references presented thusfar.

[10, 11] The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. See *Carmen Indus., Inc. v. Wahl*, 724 F.2d 982, 989-40, 220 USPQ 481, 487 (Fed Cir 1983) (noting that, while theoretically possible, "[d]ouble patenting is rare in the context of utility versus design patents"). *In re Thornton*, 57 C.C.P.A. 759, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969). (Double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure"). *In re Pheasant*, 40 C.C.P.A. 1023, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). *In re Barter*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). *In re Haygroves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931). In these cases, a "two-way" test is applicable. See *Carmen*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 724 F.2d 932, 220 USPQ at 487. See also *Broad*, 987 F.2d at 593, 19 USPQ2d at 1292 (explaining two-way test).

B. In making its double patenting rejection, the Board concluded that all but one of the pending claims of Demiczak's utility application would have been merely an obvious variation of the claims of the earlier issued design patents—the Demiczak '023 and '254 references—in light of the Holiday reference. The remaining claim, dependent claim 49, was judged obvious in light of the combination of the Demiczak design patents, Holiday, and the Kessler reference.

[12, 13] Acknowledging that the two-way test was required by *Carmen*, 724 F.2d at 940, 220 USPQ at 487, the Board concluded that "the design claimed in each of appellants' design patents does not exclude the features pertaining to the construction and color of the bag, the use of a plastic material for making the bag, the size or thickness of the bag, or the use of various types of filling material."

The particular details of the facial indicia would have been a matter of design choice as evidenced by the Holiday handbook," and that therefore, in view of Holiday, the claims of the design patents were obvious variants of the pending utility patent claims. See *Demiczak*, slip op. at 11. We disagree. In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are "basically the same as the claimed design." *In re Borden*, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed Cir 1996). *In re Rosen*, 673 F.2d 888, 391, 213 USPQ 347, 350 (CCPA 1982). The phrase "having facial indicia thereon" found in the claims of the pending utility application is not a design reference that is "basically the same as the claimed design." *Borden*, 90 F.3d at 1574, 39 USPQ2d at 1526. In fact, it describes precious little with respect to design characteristics. The Board's suggestion that the design details were simply "a matter of design choice" evinces a misapprehension of the subject matter of design patents. *B.G. Carmen*, 724 F.2d at 939 n. 13, 220 USPQ at 486 n. 13 ("Utility patents afford protection for the mechanical structure and function of an invention whereas design patents protection concerns the ornamental or aesthetic features of a design."). Indeed, we note that the two design patents do issue here—the Demiczak '023 and '254 patents—were considered nonobvious over each other, and were even the subject of a restriction requirement. See 35 U.S.C. § 121 (1994) ("If two or more independent and distinct inventions are claimed in one

application, the Commissioner may require the application to be restricted to one of the inventions"). 37 C.F.R. § 1.142. The position adopted by the Board—that a textual description of facial indicia found in the claims of the utility patent application makes obvious the specific designs claimed in the (patentably distinct) Demiczak design patents—would "presumably" render obvious, or even anticipate, all design patents where a face was depicted on a bag. But this, of course, is not the law; the textual description cannot be said to be a reference "basically the same as the claimed design," of the design patents at issue here. *Borden*, 90 F.3d at 1574, 39 USPQ2d at 1526 (internal quotation marks omitted). The Board's conclusion of obviousness is incorrect.

"Because we find that the Board erred in concluding that the design patents were obvious variants of the pending utility claims, we need not address the other prong of the two-way double patenting test—whether the pending utility claims are obvious variations of the subject matter claimed in the design patents." See *Carmen*, 724 F.2d at 939, 220 USPQ at 487 (both prongs of the two-way test required for obviousness-type double patenting). The double patenting rejections are reversed.

IV

Because there is no evidence in the record of a suggestion, teaching, or motivation to combine the prior art references asserted against the pending claims, the obviousness rejections are reversed. In addition, because the Board misapplied the test for obviousness-type double patenting, and because the pending utility claims do not render obvious the design patents, the double patenting rejections are also reversed.

REVERSED.



PENTAGEN TECHNOLOGIES INTERNATIONAL LIMITED, Plaintiff-Appellant,

UNITED STATES, Defendant-Appellee.

No. 98-5133.

United States Court of Appeals,
Federal Circuit.

May 3, 1999.

Owner of copyright for computer software program brought infringement action against the United States. The United States Court of Federal Claims, James T. Turner, Jr. dismissed action, and owner appealed. The Court of Appeals, Friedman, Senior Circuit Judge, held that statute, which bars recovery for any copyright infringement by the government, committed more than three years before filing of complaint was not equitably tolled.

Affirmed.

1. Limitation of Actions—104.5.

Statute which bars recovery for any copyright infringement by the government committed more than three years before the filing of the complaint was not equitably tolled prior to copyright holder's receipt of witness statement disclosing infringement, absent allegation that government concealed the alleged infringement, or that copyright holder was unaware of the infringement until such receipt. 28 U.S.C.A. § 1498(b).

2. Federal Civil Procedure—1754.

Even where equitable tolling might apply, a complaint properly may be dismissed for failure to state a claim as time-barred if (1) the face of the complaint shows that the claim is time-barred.

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ate "Under the statute, the Commissioner can only 'suspend or exclude' an attorney. The single incident of misconduct here has not been shown to meet the threshold level of culpable intent for such action."

Court of Appeals, Federal Circuit

Gould v. Quigg

No. 86-1274

Decided June 25, 1987

PATENTS

1. Patentability/Validity — Adequacy of disclosure [enablement] (§115, 111)

Federal district court did not err, in reversing finding by patent examiner and by Board of Patent Appeals and Interferences that patentee had presented no evidence to overcome prima facie case of lack of enablement, by accepting testimony of "expert" who, in determining his opinion as to whether disclosure was enabling at time of application's filing date, relied upon technical article that was published after filing date.

2. Patentability/Validity — In general (§115, 101)

Federal district court lacks authority, in action under 35 USC 145 to set aside decision of Board of Patent Appeals and Interferences affirming examiner's rejection of claims to direct issuance of patent, but rather court should authorize Commissioner of Patents and Trademarks "to issue such patent on compliance with the requirements of law."

Appeal from District Court for the District of Columbia, Flannery, J., 229 USPQ 1. Action by Gordon Gould against Donald J. Quigg, Commissioner of Patents and Trademarks, under 35 USC 145. From decision directing Commissioner to issue patent, Commissioner appeals. Affirmed in part, vacated in part, and remanded.

Fred E. McKelvey, deputy solicitor (Joseph F. Nakamura, solicitor, with him on brief), for appellant.

Roy H. Wepner of Lerner, David Littenberg, Krumholz & Mentlik, both of Westfield, N.J., and R. V. Lupo of Lupo, Lipman & Lever, both of Washington, D.C. (Sidney David, William L. Mentlik, and Lerner, David Littenberg, Krumholz & Mentlik, all of Westfield, N.J., with them on brief), for appellee.

Before Bennett, Senior Circuit Judge, and Bissell and Archer, Circuit Judges.

Bissell, Circuit Judge.

This is an appeal from the judgment of the United States District Court for the District of Columbia directing the Commissioner of Patents and Trademarks to issue a patent containing claims 1-15 of U.S. Application No. 823,611 (611) filed August 11, 1977, "insofar as they relate to a gas discharge amplifier." *Gould v. Mosinghoff*, 229 USPQ 1, 14 (D.D.C. 1985). We affirm in part, vacate in part, and remand.

BACKGROUND

The application in suit arrives at this court after a long, arduous journey through the patent continuation, division, and interference practices in the U.S. Patent and Trademark Office (PTO), starting with an application filed on April 6, 1959. U.S. Application No. 804,540. (540). See 35 U.S.C. §§ 120, 121, and 135. While the 540 application disclosed many inventions in laser technology, the 611 application relates only to gas discharge light amplifiers that employ atomic and subatomic particle collisions in gases to amplify light by stimulated emission of radiation.

A more detailed treatment of the technology can be found in prior decisions related to this application. *Gould v. Mosinghoff*, 215 USPQ 310 (D.D.C. 1982), *rev'd*, 714 F.2d 396, 219 USPQ 383 (D.C. Cir. 1983), *on remand*, 229 USPQ 1 (D.D.C. 1985). Court decisions involving patent applications containing essentially the same disclosure as the 611 application, but claiming different inventions and involving different issues have been numerous. See *Gould v. Control Laser Corp.*, 705 F.2d 1340, 217 USPQ 985 (Fed. Cir.), *cert. denied*, 464 U.S. 935, 1220 USPQ 3451 (1983); *in re Gould*, 673 F.2d 1385, 213 USPQ 628 (CCPA 1982); *Gould v. Helwath*, 472 F.2d 1383, 176 USPQ 515 (CCPA 1973); *Gould v. Schawlow*, 363 F.2d 908, 150 USPQ 634 (CCPA 1966); *Patex Corp. v. Mosinghoff*, 585 F.Supp. 713 (220 USPQ 342) (E.D. Pa. 1983), *aff'd in part and vacated in part*, 738 F.2d 594, 225 USPQ 243 (Fed. Cir.), *cert. granted*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985).

During prosecution of the 611 application the PTO rejected the claims under 35 U.S.C. § 112, since the 540 application failed to meet the disclosure and enablement requirements of this section of the statute. Upon Gould's appeal to the Patent and Trademark Office Board of Patent Appeals and Interferences (Board), the Board affirmed those rejections by the examiner. Gould instituted a civil action on August 11, 1977, under 35 U.S.C. § 145 (1976) seeking an order from the district court authorizing the Commissioner of Patents and Trademarks to issue to Gould a patent based on his application.

In light of new evidence presented in the district court proceeding, the district court found that "the decisions by the examiner and the Board were incorrect." 229 USPQ at 9 (FF 87). The district court found that "[t]he examiner had no evidentiary basis to question the adequacy of Gould's disclosure, and Gould's disclosure should have been accepted as presumptively enabling." *Id.* at 9-10 (FF 86). Furthermore, the district court went on to conclude that the specification of Gould's patent application contained "a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." *Id.* at 11, 13 (FF 94, CL 4). The district court then directed the Commissioner to issue to Gould a patent including claims 1 through 15 as set forth in the application. *Id.* at 14 (FF 3). General familiarity with the district court's findings of fact and conclusions of law is presumed.

ISSUES

The Commissioner raises the following issues in this appeal:

1. Whether the district court erred in concluding that the examiner, and the Board lacked a reasonable basis for doubting the enablement in Gould's application.

2. Whether the district court erred, as a matter of law, in crediting certain testimony upon which it based its conclusion that the 540 application contained an enabling disclosure for a gas discharge light amplifier, i.e., whether the 540 application en-

abled one skilled in the art to achieve a population inversion in the amplifying system.

3. Whether the district court erred, as a matter of law, in directing as opposed to authorizing the Commissioner to issue a patent.

OPINION

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134 may have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia.

The court may adjudicate that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law." 35 U.S.C. § 145 (1982 & Supp. III, 1985). While the evidentiary record before the Board serves as the "evidentiary nucleus" of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence. *Fregeau v. Mosinghoff*, 776 F.2d 1034, 1035, 227 USPQ 848, 850 (Fed. Cir. 1985); see also *Hoover Co. v. Cor*, 325 U.S. 79, 83, 165 USPQ 180, 181 (1945). ("In an action under 35 U.S.C. § 65, the predecessor to section 145, a formal trial is afforded on proof which may include evidence not presented in the Patent Office." [Footnote omitted].) Furthermore, in such an action, the district court can set aside the Board's fact findings only if they are clearly erroneous, but if new evidence is presented on a disputed question of fact, a *de novo* fact finding is made by the district court. *Fregeau*, 776 F.2d at 1038, 227 USPQ at 851; see also *Morgan v. Daniels*, 153 U.S. 120, 125 (1894). ("The decision [in the Patent Office] must be accepted as controlling upon [a] question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction.")

Enablement under 35 U.S.C. § 112, first paragraph, is a question of law. See, e.g., *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960 n.6, 220 USPQ 592, 599 n.6 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 833, 1225 USPQ 2321 (1984). However, in this case, extensive additional evidence directed not to the ultimate legal question of enablement, but to the numerous factual underpinnings

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was presented to the district court. Accordingly, we review the district court's judgment in this case, as we would any bench trial, for clearly erroneous findings of fact and errors of law. *Fregeau* 776 F.2d at 1037, 227 USPQ at 851; see Fed. R. Civ. P. 52(a), *Atlas Powder Co. v. E. I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1573, 224 USPQ 409, 411 (Fed. Cir. 1984) (appellant must establish that the district court's legal conclusions were erroneous, or that the underlying findings were clearly erroneous); see also *Anderson v. City of Besenher City*, North Carolina, 470 U.S. 564, 573 (1985).

I

The gist of the Commissioner's contention on appeal is that the Board's affirmation of the examiner's rejection of the '611 application should be affirmed because the examiner had a reasonable basis for doubting the enablement of Gould's '540 application and Gould presented no evidence either before the Board or the district court to rebut this *prima facie* case of lack of enablement. Even if the Commissioner is correct in his contention that the examiner presented before the Board a *prima facie* case of lack of enablement and that the district court erred when it held to the contrary, an automatic reversal of the judgment of the district court does not follow. Since the Commissioner does not prevail on his contention that Gould presented no evidence before the district court to overcome the asserted *prima facie* case of lack of enablement, we need not, and do not, address the issue of whether the examiner had a reasonable basis for doubting the enablement of the '540 application.

II

The Commissioner contends that, as a matter of law, the district court erred in relying on a post-1959 expert opinion (Dr. Franken's testimony) based upon two rationales, when: (a) one rationale, (a post-1959 technical article) is irrelevant as a matter of law; and (b) the other rationale (a post-1959 laser device) was found insufficient by the district court.

Dr. Franken, Gould's expert, testified that the disclosure in the '540 application, when considered in conjunction with the state of the art as it existed as of the application's April 6, 1959, filing date, was sufficient to enable one of ordinary skill to build, without undue experimentation, a sodium-mercury light amplifier. As its initial argument, the

Commissioner would have this court hold that the district court should have totally disregarded Dr. Franken's testimony because his opinions concerning the state of the art in 1959 were not based upon his having personally built a laser circa 1959. In addition, since the trial took place some 26 years after Gould's filing date, Dr. Franken's opinion was based essentially upon knowledge acquired by him during the intervening years between 1959 and 1985.

The Commissioner points to competing expert testimony to support the Board's decision. While the experts did hold different opinions, the district court specifically commented on Dr. Franken's credibility, stating:

The court accords more weight to the testimony of Dr. Franken than to the testimony of Dr. Feldman. Both experts are highly qualified, but in the court's opinion, Dr. Franken's credentials and more impressive. His manner of testifying and the reasons given for his opinions have convinced the court as the factfinder to accept his expert testimony over the conflicting expert testimony of Dr. Feldman. 229 USPQ at 10 (FF 93).

The district court was fully aware of the 26-year time interval between Gould's filing date and the trial and must be presumed to have considered it in finding the facts. Perhaps one reason the district court credited Dr. Franken's testimony over that of Dr. Feldman is that Dr. Franken was a person skilled in the relevant art at the time of Gould's filing date. *Id.* at 2 (FF 6-7). In any event, as stated in *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 552, 222 USPQ 4, 6 (Fed. Cir. 1984), "[t]he credibility of the witnesses and the weight to be given to their testimony and the other evidence in the record, however, is a matter for the trier of the facts." See also *Anderson*, 470 U.S. 564.

In attempting to discount the testimony of Dr. Franken, the Commissioner argues that as of Gould's filing date, no person had built a light amplifier or measured a population inversion in a gas discharge. "The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it." *In re Chittowsky*, 29 F.2d 457, 461, 108 USPQ 321, 325 (CCPA 1956); see also *In re Ferns*, 417 F.2d 1072, 1074, 163 USPQ 609, 611 (CCPA 1969).

The Commissioner argues that Dr. Franken's testimony is worthless, because the foundation for his expert opinion was based solely upon his reliance on: (1) a technical article published after Gould's filing date

and (2) a laser device built after the filing date, both of which the Commissioner contends must be disregarded. This argument as to the worthlessness as a whole of Dr. Franken's testimony is without merit.

[1] As to the technical article, it is true that a later dated publication cannot supplement an insufficient disclosure in a prior dated application to render it enabling. In this case, the later dated publication was not offered as evidence for this purpose. Rather, it was offered as evidence of the level of ordinary skill in the art at the time of the application and as evidence that the disclosed device would have been operative. Compare *In re Hogen*, 559 F.2d 595, 605, 194 USPQ 527, 537 (CCPA 1977). ("This court has approved use of later publications as evidence of the state of the art existing on the filing date of an application." (footnotes omitted) (emphasis in original)) with *In re Glas*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974) (later publications which add to the knowledge of the art cannot be used to supplement an insufficient disclosure); cf. *Hirschfeld v. Banner*, 462 F.Supp. 135, 142, 200 USPQ 276, 281 (D.D.C. 1978), *aff'd*, 615 F.2d 1368 (D.C. Cir. 1980), *cert. denied*, 450 U.S. 994 [210 USPQ 776] (1981) ("factual evidence directed to the amount of time and effort and level of knowledge required for practice of the invention from the disclosure alone... can be expected to rebut a *prima facie* case of nonenablement."); *In re Potlitz*, 376 F.2d 328, 330 n.1, 153 USPQ 407, 408 n.1 (CCPA 1967) ("Whether or not an invention would be deemed operative by one of ordinary skill in the art is determined, not at the time the invention was made but rather (at the earliest) at the time of the examiner's call for proof."). It was not legal error for the district court to accept the testimony of an expert who had considered a later publication in the formulation of his opinion as to whether the disclosure was enabling as of the time of the filing date of the '540 application.

There is no disagreement between the district court and the Commissioner that the laser device built after the filing date does not duplicate the amplifier disclosed by Gould in 1959 and that the construction of the device had doubtful probative value. The district court concluded that "[t]he evidence regarding the Optelecom device" does not prove by a preponderance of the evidence either that Gould's disclosure is enabling or that sodium and mercury without argon will work. *Id.* at 10 (FF 95). The finding that one piece of evidence, offered by the prevailing party, is not probative, does not require

reversal of the district court's conclusion on enablement. Dr. Franken gave underlying reasons to support his opinion "[q]uite apart from [his] consideration of the [post-1959 technical article] and apart from the [post-1959 laser device]" that Gould's specification was enabling to one of ordinary skill in the art. Appendix at 205.

Thus, regardless of whether the examiner was correct in questioning enablement during prosecution, once a full trial on the issue occurred that flushed out the actual state of the art and level of experimentation, the district court reached a distinct and more informed conclusion on enablement. We find no legal error in the district court's reliance on Dr. Franken's testimony to support its conclusion of enablement.

III

[2] Turning now to the issue of whether the district court has authority to direct the issuance of a patent, we conclude it does not. An action under 35 U.S.C. § 145 is, in essence, an action to set aside a decision of the Board and to resolve questions of patentability to the extent issues are raised at trial. See *Hoover Co. v. Coe*, 325 U.S. 79, 85 (1955) (USPQ 180, 183) (1945). ("The issue was whether the district court had jurisdiction to review a final rejection of a claim for the purposes of providing a subsequent interference.") *Fregeau*, 776 F.2d at 1037, 227 USPQ at 851 ("[I]f action not seriously be contended that a § 145 action is other than one to overturn the board's decision."). It matters not that additional evidence is permitted in a civil action under section 145, allowing the district court to make *de novo* fact findings. See *In re Fisher*, 448 F.2d 1406, 1407, 171 USPQ 292, 293 (CCPA 1971) ("As we have often pointed out, we pass only on rejections actually made and do not decree the issuance of patents."). We presume that the Commissioner will follow a proper order issued by the district court and perform the duties imposed upon the PTO by statute. See *Hoover*, 325 U.S. at 88 (1955) (USPQ 184-85).

CONCLUSION

Since the Commissioner has not convinced this court that any finding of fact is clearly erroneous, or that there are errors of law of that portion of the district court's judgment setting aside the Board's decision is affirmed. However, since the district court's order directed the Commissioner to issue a patent for the '611 application, we vacate the

order, to the extent that it so directs and remand for issuance of an order that "shall authorize the Commissioner to issue such patent on compliance with the requirements of 35 U.S.C. § 145 (1982; & Supp. III 1985).

AFFIRMED-IN-PART AND REMANDED

Court of Appeals, Federal Circuit
Gray v. Daffy Dan's Bargaintown
No. 86-1508
Decided July 2, 1987

TRADEMARKS AND UNFAIR COMPETITION

1: Practice and procedure in Patent and Trademark Office — Interparties PTO proceedings — Concurrent use proceedings — In general (8325.0307.03)

Trademark Trial and Appeal Board properly held, in proceeding by junior user seeking concurrent registration of "Daffy Dan's" for retail clothing store, that junior user's admitted conflicting use of mark in acknowledged trading area of mark's senior user and for closely related services warrants finding of likelihood of confusion as matter of law, so that junior user is not entitled to concurrent use, registration and senior user is entitled to summary judgment, since issue of likelihood of confusion in concurrent use proceeding is based upon concurrent use applicant's area of actual use, not merely use claimed in application.

Appeal from Patent and Trademark Office Trademark Trial and Appeal Board, 229 USPQ 474.

Concurrent use proceeding, No. 571, by Daniel R. Gray, doing business as Daffy Dan's, application, Serial No. 371,877, filed June 28, 1982, against Daffy Dan's Bargaintown. From decision granting senior party Daffy Dan's Bargaintown's motion for summary judgment, junior party Gray appeals. Affirmed, 2 T.P.R. 201, 1987-1-1, 1987-1-1. Mark M. Kushner, D. Peter Hochberg, with him on brief, both of Cleveland, Ohio, for appellant.

Roy H. Weppner of Lerner, David, Littenberg, Krumholz & Mentlik, both of Westfield, N.J., for appellee.

Before Markey, Chief Judge, and Nies and Bissell, Circuit Judges.

Nies, Circuit Judge.

Daniel R. Gray appeals from the decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board, in Concurrent Use No. 571, granting summary judgment in favor of the senior party and prior user, Daffy Dan's Bargaintown (DDB). Gray, the junior party, and later user, seeks a concurrent use registration for substantially the identical mark for identical and closely related services. Gray admits, however, that he is using the mark in DDB's trading area. Because of the likelihood of confusion arising from this overlapping use, the board held that Gray had no right under the statute to a concurrent use registration. We affirm.

BACKGROUND

DDB filed an application, Serial No. 281,757, on October 14, 1980, seeking an unrestricted registration of the service mark DAFY DAN'S for retail clothing store services, claiming use since 1961. Gray, the appellant herein, opposed DDB's application, asserting "concurrent rights" in the mark for such services, and then filed application Serial No. 371,877, on June 28, 1982, seeking a registration for DAFY DAN'S for the same and closely related services for all of the United States except New Jersey, in which state Gray acknowledged DDB's prior rights. The opposition was suspended pending examination of Gray's application and, thereafter, the subject concurrent use proceeding was instituted.

As a result of discovery, DDB obtained an admission that Gray was using his mark in connection with clothing distributorship services in New Jersey. Based on that ad-

The opinion of the board is reported at 229 USPQ 474 (TTAB 1986).

Gray's services are stated in his application to be "retail clothing store services and clothing distributorship services." It is unclear, exactly what services are intended by the latter description. The record shows that Gray has a retail clothing business in clothing. Gray's asserted date of first use in July, 1973. The record also shows Gray's mark in a special style of type but the marks are otherwise identical.

mitted overlapping use, DDB moved for summary judgment, asserting that Gray could not establish entitlement to a concurrent use registration inasmuch as the respective uses of the parties were likely to cause confusion of the public. The board granted summary judgment, and this appeal followed.

II The Issue

Did the Trademark Trial and Appeal Board err in refusing to grant a concurrent use registration where the junior party admitted to use of his mark in the trading area of the senior party?

III

We agree with the board that, because of Gray's admission of conflicting use of the mark DAFY DAN'S in the acknowledged trading area of DDB, no genuine issue of material fact is present which precludes the grant of summary judgment and that DDB is entitled to a final judgment as a matter of law in this proceeding.

Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d) (1982), provides in pertinent part:

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature, unless it—

(d) Consists of or comprises a mark which so resembles a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. *Provided*, That when the Commissioner determines that if confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the place of use of the marks, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their (1) concurrent lawful use in commerce prior to (a) the earliest of the filing dates of the applications pending. In issuing con-

current registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such mark is registered to the respective persons.

The board held that to be entitled to a concurrent use registration, Gray had the burden to show, *inter alia*, no likelihood of confusion between the marks of the parties by reason of their concurrent use. For purposes of the summary judgment motion, the undisputed facts are that DDB, the senior party, began using DAFY DAN'S with New Jersey in connection with retail clothing store services since prior to any use by Gray and advertised its services in interstate commerce; that DDB was the first to file for registration of its mark; that Gray began use of DAFY DAN'S for retail clothing store services in Ohio without knowledge of DDB's use; that Gray expanded his business under the mark DAFY DAN'S and admits current and continuing use in DDB's trading territory. In view of these facts, the board concluded that likelihood of confusion between the respective uses of the marks followed as a matter of law and, thus, Gray was not entitled to a concurrent use registration.

IV

It is Gray's position that the issue of likelihood of confusion in a concurrent use proceeding is to be determined with respect to the geographic area which the concurrent use applicant "claims" in its application for registration and not on the basis of actual territorial use of the respective marks.

Gray first argues that the board decision here conflicts with its own decisions in which the board has stated that "it must be determined that confusion is unlikely to result from the continued use of applicant's mark in the territory claimed." *Big M, Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985). Similar statements are quoted from other board opinions, e.g., *Over the Rainbow Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 882 (TTAB 1985); *Ole Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912.

Gray on appeal questions DDB's proof of priority, an issue not raised below and, thus, before us. He alters his argument in his reply brief to an attack on DDB's use outside New Jersey as "minimal." Neither issue is material to resolution of the issue of lay raised by the summary judgment motion.

of the working models after the tests, contemplated to be returned to petitioner four days after the trial date, and that the NBS, on reasonable notice to petitioner, could dismantle or destroy the device.

Upon petitioner's objections, the district court modified the PTO's Rule 34 request in that the NBS was ordered to complete its evaluation and make its report in thirty days rather than seven months, and Newman, his counsel, and one other person would be allowed to observe "any final tests." The NBS was expressly permitted to render any of all of the devices inoperable in part or in whole if necessary to make its determinations affordable, and the requirement that prior notice of dismantling or destruction be given to petitioner was not included in the court's order.

Analysis

Because this court, and only this court, has jurisdiction over any appeal from a final decision in this case, it has jurisdiction to hear and decide this petition. *In re Mark Industries*, 751 F.2d 1219, 224 USPQ 521 (Fed. Cir. 1984); *Mississippi Chemical Corp. v. Swift Agricultural Chemicals Corp.*, 717 F.2d 1574, 219 USPQ 577 (Fed. Cir. 1983).

(1) Petitioner asserts that the test conditions authorized by the district court are unreasonable, and thus that the order exceeds the district court's discretionary authority. The petitioner alleges irreparable harm if this court does not intervene. We conclude that a prima facie case of irreparable harm has been made by the district court's authorization that the NBS may destroy petitioner's machine, and is supported by other irregularities in the proposed procedures. Mandamus is appropriate because no subsequent appeal will necessarily redress any damage. See *J. Moore, B. Ward & J. Lucas, Moore's Federal Practice* ¶110.28 (2d ed. 1985). See also *Schlegelhaus v. Holder*, 379 U.S. 104, 110 (1964) (review by mandamus is appropriate in view of the "undecided question of the appellate court's power in these 'unusual circumstances'").

Petitioner states that during the course of patent prosecution he had offered the machine to the PTO for testing. The examiner refused to view the machine when he was in Mississippi for depositions in this action. Petitioner asserts that this history shows his past readiness and willingness to produce his machine for testing, and that the PTO having refused these opportunities can not now insist on such tests. Petitioner also states his willingness now to pro-

duce the machine under reasonable conditions.

We have recently held that the PTO is entitled to reject an application for insufficient proof when a device by its nature occasions reasonable skepticism as to its operative nature under §101. *Fregeau v. Mosinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985). See also *In re Lang*, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974). We discern no abuse of discretion in the holding of the district court that additional tests of petitioner's device should be conducted.

When petitioner had objected to the "extraordinary burden" imposed by the test conditions authorized by the district court, the court responded that this "unprecedented" device "needs precedented [sic: unprecedented?] procedural adaptations of the Federal Rules." However, the Federal Rules of Civil Procedure are more than guidelines for orderly litigation; they ensure that the proceedings are conducted fairly, with the objective of uncovering the truth, and in accordance with fundamental principles of due process.

We are not told why routine Rule 34 safeguards must in this case be denied, nor why it is essential that the NBS have authority to destroy the machine in order to determine if it operates as described. The record before us contains no allegation that the machine does not correspond with the specification, and we do not here deal with any basis for rejection other than the asserted lack of utility under §101.

The PTO represents in its brief that the NBS will not dismantle or destroy the device until it has first determined that the device works in accordance with the specification. From this, we assume that the purpose of the destruction would be to determine not if, but how, it works. The PTO is not a guarantor of scientific theory and, although the record shows that the laws of thermodynamics were debated before the district court, it is not the province of the PTO to ascertain the scientific explanation. See *In re Alfauvey*, 399 F.2d 275, 283, 158 USPQ 351, 357 (CCPA 1968) (applicant is not legally required to comprehend the scientific principles on which the practical effectiveness of his invention rests). Thus, although we encourage petitioner to cooperate in the testing program, at the risk of adverse inferences as mentioned by the district court, we agree with petitioner that his device should not be dismantled or destroyed without his consent.

Rule 34 discovery is a common procedure as is inter partes testing in general, arising in actions where there is a need to conduct inspec-

tions and tests for evidentiary purposes. Such tests routinely are made in the presence of the opposing party, and the test data are routinely provided to all parties. *Wagoner v. Barger*, 463 F.2d 1377, 1382, 175 USPQ 85, 88 (CCPA 1972). ("the results of tests made by one party without notice to, and in the absence of, the other party [are] for that reason alone entitled to little or no weight"). *Conquest Industries, Inc. v. Armstrong Corp.*, 139 F. Supp. 714, 716, 168 USPQ 263, 264 (E.D. Pa. 1970) ("the established doctrine that evidence of experiments conducted by an interested party in the absence of his adversary, is always received with suspicion and given only negligible probative value").

(2) The objectivity of the test is a fundamental rule not only of evidence but of science. The Bureau of Standards enters this arena with the aura of a national laboratory of scientific distinction, unattained by partisan obligation. Yet the record relates that a spokesman of the NBS, criticized to the press, the machine that the NBS had not yet tested. Petitioner advises that there was submitted by the PTO to the district court the affidavit of an employee of the NBS, criticizing the machine that he had, neither seen nor tested. These events support petitioner's argument that the safeguards of inter partes representation should not be denied.

Petitioner also complains that the PTO has not undertaken, or been ordered, to be bound by the findings of the NBS. However, it is not this case under 35 U.S.C. §145. The court has not abused its discretion by declining to decide in advance how the test results will be treated.

We conclude that the district court exceeded its discretionary authority in departing from standard procedures and safeguards implementing Rule 34, to the extent that fundamental fairness is absent from the tests as authorized. The court presented no reason for barring petitioner from observing all the tests on his device, or from knowing in advance what tests are to be conducted. Such procedures are highly irregular, and taint the evidentiary value of the test results. We have been directed to no instance where they have been condoned.

Therefore, IT IS ORDERED THAT:

(1) The stay of the district court's order of October 2, as modified on October 9 is lifted, and compliance therewith is ordered, subject to the following modifications:

(a) Petitioner is to produce his device for testing at the NBS, within fourteen days after notification of this order.

(b) Prior to said production date, the PTO shall request the NBS to design a

testing program that tests the utility set forth in the specification, but does not require dismantling or destruction of the device; the NBS shall notify the parties of that program before testing begins.

(c) Both parties shall have the right to observe all tests.

(d) Upon issuance of the NBS test report, copies of which shall be supplied to both parties, petitioner's device shall forthwith be returned to petitioner.

In all other respects the district court's order is affirmed. Attention is directed to the requirement that the tests be completed and the report issued within 30 days after delivery of the device.

Court of Appeals, Federal Circuit

In re Hall

No. 85-2338

Decided January 16, 1986

PATENTS

1. Patentability — Anticipation — Publications — What is publication? (851,2227)

Library director's affidavits which, based on general library practice, establish that dissertation was available to readers prior to critical date supports finding that thesis was available as "printed publication," since competent evidence of general library practice may be relied upon to establish approximate time when thesis became available.

Appeal from United States Patent and Trademark Office Board of Appeals.

Reissue application of Leo M. Hall, application Serial No. 343,922, filed January 29, 1982. From rejection of Claims 1-25, applicant appeals. Affirmed.

John F. Fero, Miami, Fla. (Boris Haskell, Arlington, Va.), on the brief for applicant.

Fred E. McKelvey, Deputy Solicitor (Joseph F. Nakamura, Solicitor, and Michael L. Gellner, Assistant Solicitor, on the brief) for Patent and Trademark Office.

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Before Baldwin, Circuit Judge; Nichols, Senior Circuit Judge; and Kashwa, Circuit Judge.*

Baldwin, Circuit Judge.

This is an appeal from the decision of the U.S. Patent and Trademark Office's (PTO) former Board of Appeals, adhered to on reconsideration by the Board of Patent Appeals and Interferences (Board), sustaining the final rejection of claims 1-25 of reissue Application No. 343,922, filed January 29, 1982, based principally on a "printed publication" bar under 35 U.S.C. § 102(b). The references is a doctoral thesis, because appellant concedes that his claims are unpatentable if the thesis is available as a "printed publication," more than one year prior to the application's effective filing date of February 27, 1979, the only issue is whether the thesis is available as such a printed publication. On the record before us, we affirm the board's decision.

Background

A protest was filed during prosecution of appellant's reissue application which included in an appendix a copy of the dissertation "1,4- α -Glucanoglucosylase ein amylolytisches Enzym" by Peter Földi (Földi thesis or dissertation). The record indicates that in September 1977, Földi submitted his dissertation to the Department of Chemistry and Pharmacy at Freiburg University in the Federal Republic of Germany, and that Földi was awarded a doctorate degree on November 2, 1977. Certain affidavits from Dr. Erich Will, who is the director and manager of the Loan Department of the Library of Freiburg University, have been relied upon by the examiner and the board in reaching their decisions. One document, styled a "Declaration" and signed by Dr. Will, states that:

[I]n November 1977 copies of the dissertation FÖLDI were received in the library of Freiburg University, and in December 1977 copies of the said dissertation were freely made available to the faculty and student body of Freiburg University as well as to the general public.

In an August 28, 1981 letter responding to an inquiry from a German corporation, Dr. Will

said that the Freiburg University library was able to make the Földi dissertation "available to our readers as early as 1977."

The examiner made a final rejection of the application claims. He said: "On the basis of the instant record it is reasonable to assume that the Földi thesis was available (accessible) prior to February 27, 1979." He also pointed out that there was no evidence to the contrary, and asked the appellant to state his "knowledge of any inquiry which may have been made regarding 'availability' beyond that presently referred to in the record." Appellant did not respond.

By letter, the PTO's Scientific Library asked Dr. Will whether the Földi dissertation was made available to the public, by being cataloged and placed in the main collection. Dr. Will replied in an October 20, 1983 letter as translated:

Our dissertations, thus also the Földi dissertation, are indexed in a special dissertations catalogue, which is part of the general users catalogue. In the stacks they are likewise set apart in a special dissertation section, which is part of the general stacks.

In response to a further inquiry by the PTO's Scientific Library requesting (1) the exact date of indexing and cataloging of the Földi dissertation or (2) "the time such procedures normally take," Dr. Will replied in a June 18, 1984 letter:

The Library copies of the Földi dissertation were sent to us by the faculty on November 4, 1977. Accordingly, the dissertation most probably was available for general use toward the beginning of the month of December, 1977.

The board held that the unrefuted evidence of record was sufficient to conclude that the Földi dissertation had an effective date as prior art more than one year prior to the filing date of the appellant's initial application. In rejecting appellant's argument that the evidence was not sufficient to establish a specific date when the dissertation became publicly available, the board said:

We rely on the librarian's affidavit of express facts regarding the specific dissertation of interest and his description of the routine treatment of dissertations in general, in the ordinary course of business in his library.

On appeal appellant raised two arguments: (1) the § 102(b) "printed publication" bar requires that the publication be accessible to the interested public, but there is no evidence that the dissertation was properly indexed in the library catalog prior to the critical date; and (2) even if the Földi thesis were cataloged

prior to the critical date, the presence of a single cataloged thesis in one university library does not constitute sufficient accessibility of the publication's teachings to those interested in the art exercising reasonable diligence.

OPINION

The "printed publication" bar is found in 35 U.S.C. § 102:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States.

The bar is grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone. *In re Bayer*, 568 F.2d 1357, 1361, 196 USPQ 670, 675 (CCPA 1978).

The statutory phrase "printed publication" has been interpreted to give effect to ongoing advances in the technologies of data storage, retrieval, and dissemination. *In re Myer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). Because there are many ways in which a reference may be disseminated to the interested public, "public accessibility" has been called the touchstone in determining whether a reference constitutes a "printed publication" bar under 35 U.S.C. § 102(b). See, e.g., *In re Bayer*, 568 F.2d at 1359, 196 USPQ at 673; *In re Myer*, 655 F.2d at 224, 210 USPQ at 792.

The § 102 publication bar is a legal determination based on underlying fact issues, and therefore must be approached on a case-by-case basis. See *id.* at 227, 210 USPQ at 795. The proponent of the publication bar must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art, so that such a one by examining the reference could make the claimed invention without further research or experimentation. See *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985); *In re Bayer*, 568 F.2d at 1361, 196 USPQ at 674; *In re Myer*, 655 F.2d at 226-27, 210 USPQ at 794-95.

Relying on *In re Bayer*, appellant argues that the Földi thesis was not shown to be accessible because Dr. Will's affidavits do not show when the thesis was indexed in the library catalog and do not chronicle the procedures for receiving and processing a thesis in the library. As the board pointed out in its decision, the facts in *Bayer* differ from those here. *Bayer*, like *Myer*, was himself the author of the dissertation cited upon by the PTO, submitted a declaration

from the university librarian which detailed the library's procedures for receiving, cataloging, and shelving of theses, and attested to the relevant dates that *Bayer's* thesis was processed. The evidence showed that cataloging and shelving theses copies routinely took many months from the time they were first received from the faculty and that during the interim the theses were accumulated in a private library, office accessible only to library employees. In particular, processing of *Bayer's* thesis was shown to have been completed after the critical date.

[1] On those facts the CCPA held that *Bayer's* thesis was not sufficiently accessible and could not give rise to the § 102(b) publication bar. But the court did not hold, as appellant would have it, that accessibility can only be shown by evidence establishing a specific date of cataloging and shelving before the critical date. While such evidence would be desirable in lending greater certainty to the accessibility determination, the realities of routine business practice counsel against requiring such evidence. The probative value of routine business practice to show the performance of a specific act has long been recognized. See, e.g., 1 Wigmore, *Evidence* § 92 (1940); rule 406, Fed. R. Evid.; 2 Weinstein, *Evidence* § 406(1), 406(1)(3) (1981). Therefore, we conclude that competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible.

In the present case, Dr. Will's affidavits give a rather general library procedure as to indexing, cataloging, and shelving of theses. Although no specific dates are cited (except that the thesis was received on November 4, 1977), Dr. Will's affidavits consistently maintain that, inasmuch as the Földi dissertation was received by the library in early November 1977, the dissertation "most probably was available for general use toward the beginning of the month of December, 1977." The only reasonable interpretation of the affidavits is that Dr. Will was relying on his library's general practice for indexing, cataloging, and shelving theses in estimating the time it would have taken to make the dissertation available to the interested public. Dr. Will's affidavits are competent evidence, and in these circumstances, persuasive evidence that the Földi dissertation was accessible prior to the critical date. Reliance on an approximation found in the affidavits such as "toward the beginning of the month of December, 1977" works no injustice here because the critical date, February 27, 1979, is some two and one half months later. Moreover, it is undisputed that appellant professed no rebuttal evidence.

BEST AVAILABLE COPY

Based on what we have already said concerning "public accessibility," and noting that the determination rests on the facts of each case, we reject appellant's legal argument that a single cataloged thesis in one university library does not constitute sufficient accessibility to those interested in the art exercising reasonable diligence.

We agree with the board that the evidence of record consisting of Dr. Will's affidavits establishes a prima facie case for unpatentability of the claims under the § 102(b) publication bar. It is a case which stands un rebutted.

Accordingly, the board's decision, sustaining the rejection of appellant's claims is affirmed. **AFFIRMED.**

District Court, N. D. Illinois

Vaughan Mfg. Co. v.
Brikm International, Inc.

No. 85 C 4121

Decided November 22, 1985

UNFAIR COMPETITION

1. Injunction — Preliminary injunction (§40.5)

Appearance of goods or labels — Color or appearance (§68.205)

Evidence demonstrating that trade dress of folding table, comprising shapes, placement, and colors of metal parts, has acquired secondary meaning through 30 years of sales and advertising, and that defendant's copying of trade dress is likely to confuse purchasing public, warrants issuance of preliminary injunction.

Action by Vaughan Mfg. Co. against Brikm International, Inc. for unfair competition under Lanham Act and state law. On plaintiff's motion for preliminary injunction. Motion granted.

Marvin N. Benn, Wayne H. Michaels, and Hamman & Benn, all of Chicago, Ill., for plaintiff.

Richard J. Ward, Jr. and Christie, Parker & Hale, both of Pasadena, Calif., and Jeffrey Clark and Wood, Dawson, Phillips, Mason

& Rowe, both of Chicago, Ill., for defendant.

Plunkett, District Judge

FINDINGS OF FACT, CONCLUSIONS OF LAW AND INJUNCTIVE ORDER

Findings of Fact

1. Plaintiff Vaughan Mfg. Co. (hereinafter "Vaughan") is an Illinois corporation in the business of manufacturing and marketing various housewares products, such as kitchen tools, can openers and bottle openers. Vaughan and its sister company, Milwaukee Metal Stamping Corp. (hereinafter "Milwaukee Metal"), a Wisconsin corporation, are both wholly owned subsidiaries of Milwaukee Stamping Co., a Delaware corporation.

2. Vaughan manufactures a portable folding table, which it calls the "Handy Table." The table is a one-piece carrying case construction that unfolds into a table and two benches seating four persons.

3. The functional aspects of the "Handy Table" were patented in 1933, which patent expired in 1950. Vaughan continued to sell its table with a label showing the number of the expired patent, until recently when it discovered that such labeling is improper. There is no evidence that such labeling was intended to deceive the public or discourage competitors.

4. Ralph Robinson, the owner of Vaughan and Milwaukee Metal, first became aware of the patented folding table in 1943. Milwaukee Metal began to manufacture the table after World War II, and began full scale production and marketing in the early 1950's. In 1975 Vaughan succeeded Milwaukee Metal as the manufacturer and principal seller of the table, although Milwaukee Metal continues to market the table.

5. Over the past thirty years, Milwaukee Metal and Vaughan have had a number of competitors selling tables like the Handy Table, and at present there are at least several other manufacturers marketing a similar product.

6. Since 1975 Vaughan and Milwaukee Metal have sold over 500,000 Handy Tables. Since 1975 Vaughan had average sales of approximately 25,000 tables per year until 1983. Since 1983 Vaughan's sales have declined, and in 1985 Vaughan has sold only about 36% of what it sold three years ago.

7. In addition to the functional elements of the table, the Handy Table has been marketed for at least the last thirty years with a arbitrary and non-functional features (with a

few minor exceptions) that constitute the trade dress of the product. This trade dress includes the coloring of the table parts, and particularly the yellow color of the table frame, which is the primary visual element when the table is closed. The trade dress also includes the shape, placement and color of some of the metal parts of the table, including the lock, handle and label.

8. Vaughan and its predecessor have advertised the "Handy Table" nationwide continually for the past thirty years. The table is advertised primarily through its display in various merchandise catalogs of sporting goods distributors and large retailers. Vaughan has given at least \$400,000.00 to \$500,000.00 in advertising allowances for such catalog advertising. Photographs of the Handy Table have appeared over the years on the pages of such catalogs as Sears, Montgomery Ward's, J.C. Penney's and Camping World, which have been distributed to many millions of customers. In addition, Vaughan and its predecessor have spent approximately \$300,000.00 to display its product in various trade shows since 1950.

9. Defendant Brikm International, Inc. (hereinafter "Brikm") began operating in early 1984. Brikm is a wholesale importer of sporting and recreational goods, and since it began operating has marketed a table called a "Fold-Out Table," which is distributed in the United States by K & S, Inc.

10. The functional, as well as the arbitrary nonfunctional elements of Defendant's Fold-Out Table, including its colors, and the shapes, placement and colors of all of the metal parts, are virtually identical to those of Plaintiff's Handy Table. In fact, in 1983 Walter Schneider, whose K & S partner G.S. Kim owns Defendant Brikm, testified that Mr. Kim purchased one of Plaintiff's Handy Tables, brought it back to Korea, and copied it for importation and marketing in the United States.

11. Although the boxes in which the two tables are packaged are quite different in appearance, in most cases the consumer never sees the box until after the point of purchase. The two tables are both marketed to the same potential customers in the same manner, namely through display at trade shows and in catalogs; in both instances, the products are displayed in open and/or closed positions without the box being visible.

12. Defendant sold no tables in 1983, 45,000 tables in 1984 and 16,000 in 1985; to date Plaintiff's sales have dropped to under 10,000 in 1985.

13. Plaintiff's arbitrary, non-functional features of the Handy Table have become distinctive through thirty years' continuous sales and advertising and have acquired a secondary meaning.

14. Defendant is the only other manufacturer of such a product that copies Plaintiff's trade dress. Other competitors, which constitute a small portion of the market, all use different design elements, and particularly different colors, to distinguish their products.

15. Because Plaintiff's and Defendant's tables look virtually identical, and are marketed in similar fashions to the same ultimate consumers, there is a likelihood of confusion among consumers as to the source of the tables.

16. Plaintiff has been damaged by Defendant's marketing of an identical product, and Plaintiff has lost control over its trade dress, and continues to lose business and suffer damage to its good-will.

Conclusions of Law

1. This court has jurisdiction over this matter by virtue of 28 U.S.C. § 1331, 1332 and 1338(a) and (b).

2. In order to prevail on its Motion for a Preliminary Injunction, Plaintiff must demonstrate that (1) it has a reasonable likelihood of success on the merits, (2) it has an inadequate remedy at law or will be irreparably harmed if the injunction does not issue, (3) the equities balance in favor of the Plaintiff, and (4) the granting of the injunction will serve the public interest. *Welsby-Jensen Div. of Schering Corp. v. Bausch and Lomb, Inc.*, 698 F.2d 862, 864, 217 USPQ 153, 154 (7th Cir. 1983).

3. Plaintiff Vaughan seeks relief for violation of Section 43 of the Lanham Act (15 U.S.C. § 1125(a)), unfair competition, violation of the Illinois Consumer Fraud and Deceptive Business Practices Act (Ill. Rev. Stat. ch. 121½ § 826.2 et seq.) and violation of the Illinois Uniform Deceptive Trade Practices Act (Ill. Rev. Stat. ch. 121½ § 831.1 et seq.) To prevail under any of these causes of action, Plaintiff must demonstrate that (1) it has protectible rights to its product configuration or trade dress, described above, and (2) use by Defendant Brikm of this trade dress is likely to result in confusion, mistake, or deception. *Hovav Manufacturing, Inc. v. Formica, Inc.*, 213 USPQ 793 (N.D. Ill. 1981); *Mark Charcoal, Inc. v. Almaric Manufacturing, Inc.*, 215 USPQ 1076 (N.D. Ill. 1981); *Clamori, Inc. v. Andrae Durnon, Inc.*, 163 USPQ 245 (Ill. Cir. Ct. 1969), *aff'd*, 14 Ill. App. 3d 646, 303 N.E.2d 177, 179 USPQ 119 (1973), *cert. denied*, 183 USPQ 321.

4. This action under 15 U.S.C. § 1125(a) is not preempted by the Sears-Roebuck doctrine. *Tempo Communications, Inc. v. Columbia Art Works, Inc.*, 223 USPQ 721 (N.D. Ill. 1983).

Chemetal's (or Morton's) knowledge and approval, markedly differs from allegations of misuse or misappropriation of secret information. Consequently, the former allegation is not displaced by the ITSA. Count IV of the plaintiff's Complaint stands.

III. Punitive Damages Claim

[2] The defendants argue that plaintiff's claim for punitive damages is based upon "some fiduciary duty owed to plaintiff by virtue of the Fraval's various employment-related contracts with Morton," and therefore untenable. (Def.'s Mem. to Dismiss, pg. 13). This court finds, however, that the punitive damage claim is allowable by statute, 765 ILCS 1065/4(b). Consequently, the count VI as alleged stands.

Conclusion

For the foregoing, the defendants' motion to dismiss counts II-V of the plaintiff's Complaint is DENIED.

Ex parte Jones

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Appeal No. 2001-1839

Decided November 28, 2001.

(Non-precedential)

PATENTS

[1] Patentability/Validity — Obviousness

— Combining references (§ 115.0905)
"Motivation" to combine teachings of prior art is not always required to support obviousness rejection under 35 U.S.C. § 103, since legally sufficient rationale for finding of obviousness may be supported by reason or suggestion in prior art, as well as motivation, to combine teachings.

[2] Practice and procedure in Patent and Trademark Office — Board of Patent Appeals and Interferences — Rules and rules practice (§ 110.1105)

Patentability/Validity — Obviousness

Relevant prior art — In general

(§ 115.0903.01)
Patent, examiner's citation of abstract in support of rejection without citation and reliance on underlying scientific article is generally inappropriate if both abstract and underlying document are prior art, and proper examination, therefore, should be based on underlying documents and translations, if necessary, since abstracts often are not written by author of underlying document, and may be erroneous; in present case, in which neither examiner nor applicant relies on underlying articles, Board of Patent Appeals and Interferences, in exercise of its discretion, will not obtain translations of underlying journal articles in order to evaluate merits of translations in first instance, since it is examiner's responsibility to obtain translations, and since review of translations by examiner and applicant may supply additional evidence as to whether there is legally sufficient reason, suggestion, teaching, or motivation to combine teachings of cited articles, and thus may eliminate need for appeal.

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Patent application of Jones, serial no. 08/947,428. Applicant appeals from examiner's rejection of claims 38 and 39 in application. Vacated and remanded.

Editor's Note: The Board of Patent Appeals and Interferences has indicated that this opinion is not binding precedent of the board. Before: Winters and William F. Smith, administrative patent judges, and McKelvey, senior administrative patent judge.

McKelvey, S.J.

Decision on appeal under

35 U.S.C. § 134

The appeal is from a decision of a primary examiner rejecting claims 38-39. We vacate and remand for action not inconsistent with views expressed herein.

A. Findings of fact

The record supports the following findings by at least a preponderance of the evidence:
1. The claimed invention relates to a method of making organic chemicals.
2. The examiner has rejected claims 38-39 as being unpatentable under 35 U.S.C. § 103(a) over:

Application for patent filed 8 October 1997, to the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

a) Homer, Surin, and Manthey, *et al.*, U.S. Pat. 5,111,111 (1992);
b) Surin, *et al.*, U.S. Pat. 5,111,111 (1992);
c) Endel, *et al.*, U.S. Pat. 5,111,111 (1992);
d) Manthey and Endel, *et al.*, U.S. Pat. 5,111,111 (1992);
e) Ota, *et al.*, U.S. Pat. 5,111,111 (1992).

3. Homer is a 25-page technical journal article written in German.
4. The examiner has placed in the record a short English-language abstract of Homer.

5. The record does not contain an English-language translation of Homer.

6. Surin is a 2-page technical journal article written in English.

7. Endel, *et al.*, is a 4-page technical journal article written in Russian.

8. The examiner has placed in the record a short English-language abstract of Endel, *et al.*

9. The record does not contain an English-language translation of Endel, *et al.*

10. Manthey is a 5-page technical journal article written in English.

11. Ota appears to be a 5-page technical journal article written in Japanese.

12. The examiner has placed in the record a short English-language abstract of Ota.

13. The record does not contain an English-language translation of Ota.

14. The examiner does not maintain that any one of the five prior art references fully describes the claimed invention. Hence, a rejection based on 35 U.S.C. § 103(a) is not proper.

15. According to the examiner, "the skilled artisan looking for an alternative route for the preparation of the product produced by the claimed method" was deemed to be aware of all the various methods of the preparation of the product (Examiner's Answer, page 4).

16. Further according to the examiner, "one ordinary skill in the art would be motivated to combine the teachings of the prior art references to prepare the compound made by applicant's claimed method" by coupling Surin's *** acid and Endel, *et al.*'s *** acid as taught by Manthey, followed by *** (further treatment) to obtain the compound as taught by Homer and subsequent reduction as taught by Ota to obtain the *** (claimed process). (Examiner's Answer, pages 4-5).

According to applicant, the requisite motivation "is not present in the prior art because [t]hroughout the prosecution the examiner has failed to point out any teaching or suggestion in the prior art that would motivate a skilled artisan to use the claimed process (Appeal Brief, page 4).

B. Discussion

1. Rationale in support of obviousness

[1] The applicant and the examiner have apparently assumed that there always must be "motivation" to combine teachings of the prior art. In support of a rejection based on § 103(a), the assumption is not correct. The word "motivation" or a word similar to "motivation" does not appear in 35 U.S.C. § 103(a). While a finding of "motivation" supported by substantial evidence, probably will support combining teachings of different prior art references to establish a *prima facie* obviousness case, it is not always necessary. For example, where a claimed apparatus requiring Phillips head screws differs from a prior art apparatus describing the use of flat-head screws, it might be hard to find motivation to substitute flathead screws with Phillips head screws to arrive at the claimed invention. However, the prior art would make it more than clear that Phillips head screws and flat-head screws are viable alternatives serving the same purpose. Hence, the prior art would "suggest" substitution of flathead screws for Phillips head screws albeit the prior art might not motivate use of Phillips head screws in place of flathead screws.

What must be established to sustain an obviousness rejection is a legally sufficient rationale as to why the claimed subject matter, as a whole, would have been obvious notwithstanding a difference between claimed subject matter and a reference which is prior art under 35 U.S.C. § 102. Once a difference is found to exist, then the examiner must articulate a legally sufficient rationale in support of a § 103(a) rejection. The legally sufficient rationale may be supported by a reason, suggestion, teaching or motivation in the prior art which would have rendered obvious the claimed subject within the meaning of § 103(a). In *re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant). In *re Garbade*, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000) (the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a teaching or motivation to combine prior art references). *Pro-Mold and Tool Co. v. Great*

Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996) ("there must be a *reason, suggestion, or motivation* *** to combine [the teachings of] *** references ***"). *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a *reason, suggestion, or motivation* in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references).

Moreover, when an examiner maintains that there is an explicit or implicit teaching or suggestion in the prior art, the examiner should indicate where (page and line or figure) such a teaching or suggestion appears in the prior art. *In re Rijkse*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), citing *In re Ives*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981).

One difficulty with the rationale in support of the examiner's rejection in this case, and for that matter the applicant's challenge to the rejection, is that it appears to be based solely on a motivation rationale without taking into account whether there otherwise is a legally sufficient *reason, showing, suggestion, or teaching* which might also suffice to support the examiner's rejection. Moreover, a suggestion, teaching or motivation to combine teachings of the prior art may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). See also *In re Garrido*, *supra* at 1319, 53 USPQ2d at 1778 (the suggestions may come from, *inter alia*, the teachings of the references themselves and, in some cases, from the nature of the problem to be solved).

If the examiner determines that it is appropriate to enter a further rejection, the examiner may wish to consider a rationale based on a suggestion, teaching or other reason in place of a rationale based exclusively on motivation.

We will also note that the examiner's theory of rejection, at least in part, seems to rely on the proposition that, if a person of ordinary

skill in the art is looking for an alternative method for the preparation of a compound, then that person would be aware of all analogous art (see Finding 15). If the examiner continues to rely on that theory, then the examiner would be under a burden to establish why a person of ordinary skill in the art would be looking for an alternative method, particularly where a method is known for making a particular compound.

2. Use of abstracts in place of underlying articles

The principal difficulty with the prosecution of the application on appeal is the examiner's attempt to establish "motivation" by reliance on three English-language abstracts of journal articles written in foreign languages. The examiner does not maintain that only Sun and Manthey, both in English, support the rejection. The use of abstracts, when the underlying document is prior art, gives us considerable pause.

The Board of Patent Appeals and Interferences continues to have recurring problems in resolving *ex parte* appeals which come before it. One continuing recurring problem is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document.

[2] In this appeal, the examiner relied upon abstracts of three technical journal articles without referring to translations of the underlying documents. Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. Abstracts often are not written by the author of the underlying document and may be erroneous. It is our opinion that a proper examination under 37 CFR § 1.104 should be based on the underlying documents, and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.

When an examiner cites and relies only on an abstract, the applicant may wish to obtain a copy of the underlying document and submit a copy to the examiner when responding to a rejection relying on an abstract. In the event a reference is in a foreign language, if the applicant does not wish to expend resources to obtain a translation, the applicant may wish to request the examiner to supply a translation if

a translation is not supplied by the examiner, the applicant may wish to consider seeking supervisory relief by way of a petition (37 CFR § 1.181) to have the examiner directed to obtain and supply a translation.

In the past, when neither the examiner nor the applicant relies on the underlying article, the board often expended the resources necessary to obtain a copy of the underlying scientific article, as well as translations thereof. When it did so, however, the burden of examining the application fell on the board in the first instance. Moreover, to the extent that the board relies on parts of a translation not previously provided to an applicant, any affirmation generally has to be a new ground of rejection under 37 CFR § 1.196(b)—which can result in further prosecution.

In this case, we do not know whether the examiner or the applicant had or reviewed the underlying foreign language technical journal articles or translations thereof. The board cannot examine, in the first instance, all applications which come before it in an *ex parte* appeal under 35 U.S.C. § 134. In this particular appeal, we exercise discretion by declining to obtain translations of the underlying technical journal articles, and thereafter evaluate on the merits in the first instance the translations. In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings of the five technical journal articles. Moreover, an evaluation of translations may eliminate the need for an appeal.

C. Decision

The decision of the examiner rejecting claims 38-39 under 35 U.S.C. § 103(a) over (1) Homer, (2) Sun, (3) Endel'man, (4) Manthey, and (5) Oia is vacated and the application is remanded to the examiner. For the effect of this decision vacating an examiner's rejection, see *In re Zambirano*, 58 USPQ2d 1312 (Bd. App. & Int. 2001) (explaining that vacating a rejection no longer exists).

The examiner and/or the applicant may obtain translations of (A) Homer, (B) Endel'man, and (C) Oia.

Nothing in this opinion should be read as precluding the examiner from entering a rejection

based on translations. In the event the examiner determines that claims 38-39 are unpatentable over the combination of the five references (or any additional prior art), then the examiner must identify and cite the specific portions (page and line or figure) of each article or prior art document upon which he relies in support of any rejection. We are primarily a board of review. Accordingly, neither the examiner nor applicant should expect, in any further appeal for us to dig through five prior art references to come up with a theory which might support or negate a rejection in the first instance. Moreover, if the examiner enters a further rejection based on foreign language document, translations must be obtained if a further appeal is taken. We will not decide a further appeal without translations. We express no views on the ultimate merits of any rejection under 35 U.S.C. § 103(a) based on the five prior art references or any additional prior art which the examiner and applicant may wish to make of record.

D. Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the examiner's rejection under § 103(a) of claims 38-39 is vacated.

FURTHER ORDERED that the application is remanded to the examiner for action not inconsistent with the views expressed in this opinion.

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

VACATED and REMANDED

Ex parte Gambogi

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Appeal No. 2001-1022

Decided December 10, 2001

(Non-precedential)

PATENTS

[1] Practice and procedure in Patent and Trademark Office. — Board of Patent Appeals and Interferences. — Rules

chaft; Kohle, M.B.H.v. Shell Oil Co., 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (CA-11, 1997) is not invalid. The judgment of the district court is affirmed.

IV

Zebco has failed to demonstrate to this court that the disputed claim terms of claim 1 of the '835 patent should be interpreted in a way other than their ordinary and accustomed meaning. Therefore, we find that the district court's claim interpretation, and the summary judgment of infringement conditioned thereon, was not erroneous.¹² We also hold that the district court correctly determined that the relevant claim of the '835 patent, as construed,

2. Johnson does not dispute that products embodying the '835 invention were on sale more than one year prior to the filing of the '254 application in July 1992.

AFFIRMED. The judgment of the district court is affirmed.

AFFIRMED



In re Anita DEMBICZAK and Benson Zinbarg, Appellants.

No. 98-1498.

United States Court of Appeals,
Federal Circuit.

April 28, 1999.

Board of Patent Appeals and Interferences upheld rejection of application for utility patent, and appeal was taken. The United States Court of Appeals for the Federal Circuit, *Clevenger*, Circuit Judge, held that: (1) Board erred by rejecting application for patent on plastic trash bags with pumpkin face on grounds of obviousness, without finding suggestion, teaching, or motivation to combine prior art references, and (2) applicant's earlier design patents involving pumpkin faces on bags did not preclude issuance of patent in present case, under obviousness-type double patenting doctrine.

Reversed.

1. Patents 113(6)

Federal Circuit determines legal ques-
tion of obviousness of patent without def-
erence to Board of Patent Appeals and
Interferences, and examines any factual
findings for clear error. 35 U.S.C.A.
§ 103(a)

3. The titles and abstracts are different, for example.

IN RE DEMBICZAK

Cite as 175 F.3d 994 (Fed Cir. 2000)

995

25 Patents 16(1)

For Measuring a claimed invention for obviousness requires the of difficult but critical step of casting the mind back to the state of one-of-ordinary skill in the art, guided solely by the prior art references and the then-accepted wisdom in the field. 35 U.S.C. § 103(a).

Patents, 16(4)

businessness analysis of a patent, applicable to a showing of the teaching or combination to combine prior art references.

Patents § 26(1)

35 USC § 103(a).

Patents 36(1)

the teaching of multiple references, standing alone, are not evidence sufficient to render invention obvious and unpatentable. 35 U.S.C.A. § 103(a).

Patents 16.27

erred by denying, for obviousness, a patent for an orange plastic trash bag with marings, expanded to show face of pumpkin filled with leaves, when Board cited art showing placement of pumpkin on crepe paper and which disclosed use of plastic trash bags and concluded prior art references collectively showed all limitations of present claims; should have found a suggestion, e.g., of motivation to combine prior references. 35 U.S.C.A. § 103(a).

7. Patents § 113(6)

Federal Circuit would not consider argument made in support of obviousness of patent application, which was not raised before Board of Patent Appeals and Interferences. 35 U.S.C.A. § 109(a)

8. Patents 120

The doctrine of "obviousness-type double patenting" prohibits claims in a second patent which define merely an obvious variation of an invention claimed by the same inventor in an earlier patent. 35

See publication Words and Phrases for other judicial constructions and definitions.

Patents, 314(5)

question whether patent application is to be rejected, under obvious-type double patenting doctrine, on grounds that claimed invention was merely an obvious variation on invention disclosed in existing patent, is one of law, which Federal Circuit views *de novo*. 35 U.S.C.A. § 103(a).

Patents 120

In some very rare cases, obvious-typeable patenting, in which invention claimed in patent application was obvious in view of prior art, has been found on invention disclosed by existing patent. 35 U.S.C.A. § 103(a).

Patents 120

When utility patent is sought to be invalidated due to obviousness, in light of prior art, the obviousness is determined by the prior art design patents, rejection under obviousness-type double patenting doctrine is appropriate only if the claims of the two patents are cross-read, meaning that the test is whether the subject matter of the claims of the patent sought to be invalidated is obvious from the subject matter of the claims of the other patent, or vice versa. *Grain Processing Co. v. Am. Corn Processors Ass'n*, 2006-10-12.

talents 28

an order for a design to be unpatentable because of obviousness, there must be a basic design reference in the

prior art, the design characteristics of which are, basically, the same as the claimed design. 35 U.S.C.A. § 103(a).

13. Patents \leftrightarrow 120

Phrase "having facial indicia thereon, contained in claim of application for utility patent on plastic trash bag with pumpkin face, was not design reference that was basically the same as claimed design covered by design patents on jack-o-lantern faces on bags, and application was consequently not required to be rejected under obviousness-type double patenting doctrine. 35 U.S.C.A. § 103(a).

David P. Gordon, of Stamford, Connecticut, argued for appellant. Of counsel was Thomas A. Gallagher, of Stamford, Connecticut.

John M. Wheahan, Associate Solicitor, Office of the Solicitor, of Arlington, Virginia, argued for appellee. With him on the brief were Albin F. Drost, Acting Solicitor, and David R. Nicholson, Associate Solicitor.

Before MAVER, Chief Judge, MICHEL and CLEVELANGER, Circuit Judges.

CLEVELANGER, Circuit Judge.

Anita Dembiczak and Benson Zimbarg appealed the rejection, upheld by the Board of Patent Appeals and Interferences, of all pending claims in their Application, No. 08/427,732. See *Ez. Porte Dembiczak*, No. 96-2648, slip. op. at 43 (May 14, 1998). Because the Board erred in sustaining rejections of the pending claims as obvious under 35 U.S.C. § 103(a) (Supp. 1998), and for obviousness-type double patenting, we reverse.

The invention, at issue in this case is, generally speaking, a large trash bag made of orange plastic and decorated with lines and facial features, allowing the bag, when filled with trash or leaves, to resemble a Halloween-style pumpkin, or jack-o-lantern.

term. As the inventors Anita Dembiczak and Benson Zimbarg (collectively, "Dembiczak") note, the invention solves the long-standing problem of unsightly trash bags placed on the curbs of America, and, by fortuitous happenstance, allows users to express their whimsical or festive nature while properly storing garbage, leaves, or other household debris awaiting collection. Embodiments of the invention—sold under a variety of names, including Giant Stuff-A-Pumpkin, Funkins, Jack Sak, and Bag-O-Fun—have undisputedly been well-received by consumers, who bought more than seven million units in 1990 alone. Indeed, in 1990, the popularity of the pumpkin bags engendered a rash of thefts around Houston, Texas, leading some owners to resort to preventative measures, such as greasing the bags with petroleum jelly, and tying them to trees. See R. Piller, "Halloween Hopes Die on the Vine," *Houston Chron.*, Oct. 19, 1990, at 13A.

The road to profits has proved much easier than the path to patentability, however. In July 1989, Dembiczak filed a utility patent application generally directed to the pumpkin bags. In a February 1992 appeal, the Board of Patent Appeals and Interferences ("the Board") reversed the Examiner's rejection, but entered new grounds for rejection. Dembiczak elected to continue prosecution, filing a continuation application to address the new grounds for rejection. Thereafter, the invention made a second appearance before the Board, in April 1993, when the Board both sustained the Examiner's rejection and again entered new grounds for rejection. Again, a continuation application was filed (the instant application). And again the Examiner's rejection was appealed to the Board, which sustained the rejection in a May 14, 1998, decision. See *Dembiczak*, slip. op. at 43.

The patent application at issue includes claims directed to various embodiments of

the pumpkin bag. Claims 37, 49, 51, 52, 58 through 64, 66 through 69, and 72 through 81 are at issue in this appeal. Though the claims vary, independent claim 74 is perhaps most representative.

74. A decorative bag for use by a user with trash filling material, the bag simulating the general outer appearance of an outer surface of a pumpkin having facial indicia thereon, comprising: a flexible, waterproof plastic trash or leaf bag having an outer surface which is premanufactured to simulate the general appearance of the outer skin of a pumpkin, and having facial indicia including at least two of an eye, a nose, and a mouth on the orange color outer surface for forming a face pattern on said orange color outer surface to simulate the general outer appearance of a decorative pumpkin with a face thereon; said trash or leaf bag having first and second opposite ends, at least said second end having an opening extending substantially across the full width of said trash or leaf bag for receiving the trash filling material; wherein when said trash or leaf bag is filled with trash filling material and closed, said trash or leaf bag takes the form and general appearance of a pumpkin with a face thereon.

All of the independent claims on appeal, namely 37, 52, 72, and 74, contain limitations that the bag must be "premanufactured orange in color," have "facial indicia," have openings suitable for filling with trash material, and that when filled, the bag must have a generally rounded appearance, like a pumpkin. Independent claims 37, 52, and 72 add the limitation that the bag's height must be at least 36 inches. (Claim 72 requires that the bag be made of a "weatherproof material," and claim 74, as shown above, requires that the bag be "waterproof." Claim 52 recites at

IN RE DEMBICZAK
Cite as 175 F.3d 996 (Fed. Cir. 1999)

"method of assembling" a bag with the general characteristics of apparatus claim 37 as recited above.

The prior art cited by the Board includes:

(1) pages 24-25 of a book entitled "A Handbook for Teachers of Elementary Art" by Holiday Art Activities ("Holiday"), describing how to teach children to "make a Crepe Paper Jack-O-Lantern" out of a strip of orange crepe paper, construction paper cut-outs in the shape of facial features, and "wadded newspapers" as filling;

(2) page 73 of a book entitled "The Eyegging Book for Teachers of Young Children," by Martha Shapiro and Valerie Indenbaum ("Shapiro"), describing a method of making a "paper bag pumpkin" by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint;

(3) U.S. Patent No. 3,349,991, to Leonard Kessler, entitled "Flexible Container" ("Kessler"), describing a bag, apparatus wherein the bag closure is accomplished by the use of folds or crumple in the bag material;

(4) U.S. Patent No. Des. 310,023, issued August 21, 1990, to Dembiczak ("Dembiczak '023"), a design patent depicting a bag with a jack-o-lantern face;

(5) U.S. Patent No. Des. 317,254, issued June 4, 1991 to Dembiczak ("Dembiczak '254"), a design patent depicting a bag with a jack-o-lantern face; and

(6) Prior art "conventional" plastic lawn or trash bags ("the conventional trash bags").

Using this art, the Board affirmed the Examiner's final rejection of all the independent claims (37, 52, 72, 74) under 35:

U.S.C. § 103, holding that they would have been obvious in light of the conventional trash bags in view of the Holiday and Shapiro references. The Board determined that, in its view of the prior art, "the only difference between the invention presently defined in the independent claims on appeal and the orange plastic trash bags of the prior art and the use of such bags resides in the application of the facial indicia to the outer surface of the bag." *Dembiczak*, slip op. at 18. The Board further held that the missing facial indicia elements were provided by the Holiday and Shapiro references' description of painting jack-o-lantern faces on paper bags. See *id.* at 18-19. Dependent claims 49 and 79, which include a "gussets" limitation, were considered obvious under similar reasoning, except that the references cited against them included Kessler. See *id.* at 7.

The Board also affirmed the Examiner's obviousness-type double patenting rejection of all the independent claims in light of the two Dembiczak design patents (923 and 254) and Holiday. See *id.* at 12. The Board held that the design patents depict a generally rounded bag with jack-o-lantern facial indicia, and that the Holiday reference supplies the missing limitations, such as the "thin, flexible material" of manufacture, the orange color, the initially open upper end, and the trash filling material. The Board also stated that the various limitations of the dependent claims—e.g., color, the inclusion of leaves as stuffing, and the dimensions—would all be obvious variations of the depictions in the Dembiczak design patents. See *id.* at 8-9. In addition, using a two-way test for obviousness-type double patenting, the Board held that the claims of the Dembiczak design patents "do not exclude" the additional structural limitations of the pending utility claims, and thus the design patents were merely obvious variations of the subject matter disclosed in the utility claims. See *id.* at 11. The Board further upheld, on similar grounds, and with the inclusion of the Kessler reference, the ob-

viousness-type double patenting rejection of dependent claim 49. See *id.* at 12. This appeal followed, vesting this court with jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A) (1994).

II

[1] A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (Supp.1989); see *Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 465 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. See *Graham*, 383 U.S. at 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ at 467; *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed.Cir.1993). We therefore review the ultimate determination of obviousness without deference to the Board, while examining any factual findings for clear error. See, e.g., *In re Zarfo*, 142 F.3d 1447, 1459, 46 USPQ2d 1691, 1700 (Fed.Cir.) (en banc), cert. granted, — U.S. —, 119 S.Ct. 401, 142 L.Ed.2d 326 (1998).

A

[2] Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see *Lockite Corp. v. Urtisecul Ltd.*, 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed.Cir.1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d

1097 (Fed.Cir.1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1559, 220 U.S.P.Q. 303, 313 (Fed.Cir.1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *Id.*

[3] Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1223, 1232 (Fed.Cir.1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998) ("the Board must identify specifically all the reasons 'one of ordinary skill in the art' would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075-56 USPQ2d 1596, 1600 (Fed.Cir.1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashtand Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed.

Cir.1985) (district court's conclusion of obviousness was error when it "did not elicit date any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. See, e.g., *Interconed, Planning Corp. v. Feltz*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time"). In this case, the Board fell into the hindsight trap.

[4, 5] We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved; see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1326, 1330 (Fed.Cir.1990); *Parv-Ordnance Mfg. v. SGS Importers Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed.Cir.1995), although the suggestion more often comes from the teachings of the pertinent references. *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. ("The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references standing alone are not evidence." E.g., *McElmurry v. Attanasio Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed.Cir.1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of

material fact"). *In re Siebert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve as a number of important purposes, including: (1) clear explanation of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

(6) All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. *See Dembiczak*, slip op. at 6-7. To justify this combination, the Board simply stated that "the Holiday and Shapiro references would have suggested the application of facial indicia to the prior art plastic trash bags." *Id.* at 18-19. However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other—in combination with each other and the conventional trash bags—described all of the limitations of the pending claims. *See id.* at 18-23. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references. *Id.* nor does the Board make specific—or even inferential—findings concerning the identi-

fication of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. *See, e.g., Pro-Mold & Tool*, 75 F.3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a "premanufactured orange" bag material, *see Dembiczak*, slip op. at 21, finds that Shapiro teaches the use of paper bags in various sizes, including "large", *see id.* at 22-23, and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice, *see id.* at 24. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. *See Rouffel*, 149 F.3d at 1357, 47 USPQ2d at 1459 (noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination"). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. *See C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1233; *Rouffel*, 149 F.3d at 1359, 47 USPQ2d at 1459; *Fritch*, 972 F.2d at 1265, 23 USPQ2d at 1783; *Five*, 837 F.2d at 1075, 5 USPQ2d at 1600; *Ashland Oil*, 776 F.2d at 297, 227 USPQ at 667.

B

(7) The Commissioner of Patents and Trademarks ("Commissioner") attempts to justify the Board's decision on grounds

different from that relied upon by the Board, arguing that one of ordinary skill in the art would have been motivated to combine the references. Of course, in order to do so, the Commissioner must do what the Board did not do below: make specific findings of fact regarding the level of skill in the art ("a designer and manufacturer of trash and leaf bags, particularly one specializing in the ornamental and graphic design of such bags"), *Resp't Br.* at 14, the relationship between the fields of conventional trash bags and children's crafts, respectively ("the artisan would also have been well aware of the ancillary, corollary, and atypical uses of 'trash' bags such as their application in hobby and art projects"), *Resp't Br.* at 15, and the particular features of the prior art references that would motivate one of ordinary skill in a particular art to select elements disclosed in references from a wholly different field ("a designer and manufacturer of trash and leaf bags would have recognized the paper bag in Shapiro to be a trash bag and therefore would have been motivated to combine it with the admitted prior art plastic trash and leaf bags to arrive at the claimed invention"), *Resp't Br.* at 15. The Commissioner also appears to cite additional references in support of this obviousness analysis, noting that at least two design patents (in the record but not cited against the presently pending claims) teach the placement of "graphical information, including text, designs, and even facial indicia, to colored bags." *Resp't Br.* at 16. This new analysis, apparently cut from whole cloth in view of appeal, does little more than highlight the shortcomings of the decision below, and we decline to consider it. *See, e.g., In re Robertson*, 169 F.3d 743, 746, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("We decline to consider [the Commissioner's] newly-minted theory as an alternative ground for upholding the agency's decision."); *In re Somi*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995); *In re Honeyfield*, 639 F.2d 1320, 1324, 216 USPQ 1045, 1049 (Fed. Cir. 1983) (rejecting an "attempt[] by the Commis-

sioner to apply a new rationale to support the rejection"), *see also* 35 U.S.C. § 144 (1994) (an appeal to the Federal Circuit "is taken on the record before The Patent and Trademark Office"). Because the Board has not established a prima facie case of obviousness, *see In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of prima facie obviousness"), we therefore reverse the obviousness rejections and have no need to address the parties' arguments with respect to secondary factors.

III

[8, 9] Dembiczak also asks this court to reverse the Board's rejection of the pending claims for obviousness-type double patenting, which is a judicially-created doctrine that seeks to prevent the applicant from expanding the grant of the patent right beyond the limits prescribed in Title 35. *See, e.g., In re Bruck*, 937 F.2d 559, 592, 19 USPQ2d 1259, 1291-92 (Fed. Cir. 1991). *In re Long*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). *See also* 35 U.S.C. § 154(a)(2) (Supp. 1998) (discussing patent term). The doctrine prohibits claims in a second patent which define "merely an obvious variation" of an invention claimed by the same inventor in an earlier patent. *Bruck*, 937 F.2d at 592, 19 USPQ2d at 1292 (quoting *In re Vogel*, 57 C.C.P.A. 920, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)). Thus, unless a claim sought in the later patent is patentably distinct from the claims in an earlier patent, the claim must be rejected. *See In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); *Vogel*, 422 F.2d at 441, 164 USPQ at 622. This question is one of law, which we review *de novo*. *See Goodman*, 11 F.3d at 1052, 29 USPQ2d at 2015; *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).